SUBJECT INDEX.

PAGE

Petition for writ of certiorari to the United States Court of Appeals for the Ninth Circuit v

Summary statement of the matter involved vi

Questions presented vii

Reasons relied upon for the allowance of the writ of certiorari x

Brief for petitioner in support of petition for writ of certiorari xiii

The opinions of the courts below xiii

Jurisdiction xiv

Statement xvi

Statutes xvi

Specification of errors xvi

Summary of argument xix

Argument 1

Point I. Invention is the sole issue 1

Point II. The law and facts involved 2

(a) A new element 3

A. The law 3

B. The facts 4

(1) A new dog 5

Preliminary explanation 6

Description of illustrative drawings 6

Figure I 7

Figure II 9

Figure III 10

Summary 12

PAGE

(2) A new dogging sub-combination 13

(3) A dual-function outwardly-sliding operating member 14

(b) A new mode of operation 15

A. The law 15

B. The facts 16

(1) The new mode of operation surrounding the new Hillgren dog 16

(2) The new mode of operation surrounding the new Hillgren operating member 17

(c) A "surprisingly" new result 19

A. The law 19

B. The facts 19

Summary 22

Conclusion 23

TABLE OF AUTHORITIES CITED

(See also the "INDEX TO APPENDIX")

CASES — PAGE

Aeration Processes v. Lange, 196 F. 2d 981.....x, xv, 4
Artmoore v. Dayless Mfg. Co., 109 Fed. Supp. 181.....x, xv, 4
E-I-M Co. v. Philadelphia Gear Works, 205 F. 2d 23.....ix, xv, 4
Great A & P Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147.....vii, viii, ix, x, xiii, xiv, xv, xvii 1, 2, 3, 4, 15, 16, 19, 21, 22, 23
Guiberson Corp. v. Garrett Oil Tools, Inc., 205 F. 2d 660..... 4
Ingersoll-Rand Co. v. Black & Decker Mfg. Co., 192 F. 2d 270 .....x, xv, 19
Interstate Rubber Products Corp. v. Radiator Specialty Co., 114 Fed. Supp. 120.....x, xv, 19
Jeoffroy Mfg. Co. v. Graham, 206 F. 2d 772.....ix, xv, 4
Mackay Radio & Telegraph Co. v. Radio Corp. of America, 306 U. S. 86, 83 L. Ed. 506..... xv
Oliver United Silvers Corp. v. Silver, 206 F. 2d 658.....x, xv, 16
Photochart v. Photo Patrol, 189 F. 2d 625.....ix, xv, 4, 19
Schriber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211, 85 L. Ed. 132..... xv
United Carbon Co. v. Binney & Smith Co., 317 U. S. 228, 87 L. Ed. 232..... xv
United Specialties Co. v. Industrial Corp., 186 F. 2d 428....x, xv, 16

RULES

Rules of United States Supreme Court, Rule 35.....3, 15, 19
Rules of United States Supreme Court, Rule 38..... vi
Rules of United States Supreme Court, Rule 38, Sec. 5(b)..... .....ix, x, xi, xii, xviii, xix

STATUTES

Revised Statute No. 4886 (35 U. S. C. 31).....xiv, xvi
United States Code, Title 28, Sec. 1254.....vi, xv

TEXTBOOKS

97 United States Patent Quarterly, p. 206.....v, vi xiv
100 United States Patent Quarterly, p. 289.....v, vii, xiii, xiv

IN THE

Supreme Court of the United States

October Term, 1953

No. .....

CARL A. HILLGREN,

Petitioner,

vs.

KWIKSET LOCKS, INC., ADOLPH SCHOEPE and KARL REINHARD,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE NINTH CIRCUIT.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your Petitioner, Carl A. Hillgren, respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the Ninth Circuit to review the Decree of that Court holding invalid United States Letters Patent No. 2,403,597. Said Decree was entered originally on March 16, 1953 (97 U. S. P. Q. 206), a petition for rehearing was granted on April 28, 1953, a rehearing was held on November 20, 1953, and the decision was virtually re-entered on February 3, 1954 (100 U. S. P. Q. 289). [R. pp. 898-914.]

This Court has jurisdiction under Title 28, United States Code, Section 1254.

A certified transcript of the record in this case, including the proceedings in the Court of Appeals, is furnished herewith in compliance with Rule 38 of the Rules of this Court.

Summary Statement of the Matter Involved.

Petitioner Carl A. Hillgren is the applicant for, and the owner of, United States Letters Patent No. 2,403,597, issued July 9, 1946, for an invention of a "Door Lock." He brought suit in the United States District Court for the Southern District of California, Central Division, against Respondents Kwikset Locks, Inc., Adolf Schoepe and Karl Reinhard for infringement and prayed for an injunction and damages. Respondents' answer denied infringement and alleged that Petitioner's patent is void for lack of novelty and invention.

A counter-claim on another patent is not in any way involved herein, so it requires no further mention.

The United States District Court found the Petitioner's patent to be valid, having both novelty and invention and also found infringement and granted Petitioner's prayers for an injunction and an accounting.

The Respondents appealed to the United States Court of Appeals for the Ninth Circuit, being case No. 13060, from the above decision of the District Court.

After briefs and oral argument were submitted the Court of Appeals for the Ninth Circuit rendered an opinion on March 16, 1953 (97 U. S. P. Q. 206), finding novelty and infringement, but erroneously holding the

patent invalid for lack of invention over the prior art patents to Schlage and Baume, when viewed by that Court in the light of that Court's erroneous application and incorrect interpretation of the decision of this Court in *Great A & P Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147.

Petitioner filed a petition for a rehearing, which was granted, and the above opinion of March 16, 1953, was withdrawn on April 28, 1953. An oral rehearing was thereafter had on November 20, 1953, but the Court of Appeals had become set in its error, and refused to correct it, so on February 3, 1954 (100 U. S. P. Q. 289), the Court of Appeals filed and entered virtually a duplicate of its above original erroneous opinion of March 16, 1953 [R. pp. 898-914].

This petition is filed respectfully requesting this Court to reverse the above erroneous opinion and entry of February 3, 1954, of the Court of Appeals for the Ninth Circuit and to grant the prayers that were prayed for in the complaint herein [R. p. 4], as they were granted by the District Court [R. pp. 21, 22-26 and 31-33, incl.].

Questions Presented.

The Decree of the Court of Appeals for the Ninth Circuit raises the following questions of law:

QUESTION 1.

When a patent claim comprises a new combination of a NEW ELEMENT and some old elements that produce a new and beneficial result and it has been held valid by the District Court, is it not contrary to law and the decisions of this Court for a Court of Appeals to hold that claim invalid for lack of invention?

QUESTION 2.

When a patent claim comprises a new combination having a NEW MODE OF OPERATION and producing a new and beneficial result and it has been held valid by the District Court, is it not contrary to law and the decisions of this Court for a Court of Appeals to hold that claim invalid for lack of invention?

QUESTION 3.

When a patent claim comprises a new combination producing "SURPRISINGLY" NEW RESULTS and it has been held valid by the District Court and the new results found in the District Court's findings, is it not contrary to law and the decisions of this Court for a Court of Appeals to hold that claim invalid for lack of invention?

QUESTION 4.

When a District Court holds that one rule of law applies to a given set of facts and the Court of Appeals holds that an entirely different rule of law applies to those same facts, is it not a question of LAW, namely, WHICH rule of law SHOULD be used, for this Court to decide under its power of supervision?

QUESTION 5.

When a Court of Appeals holds a patent claim invalid for lack of invention is not that a question of CONSTITUTIONAL LAW in every case and should not the Supreme Court "speak with final authority" on that constitutional issue in every patent case where the question of invention is involved, including specifically the instant case, under the concurring decision of Justice Douglas in *Great Atlantic & Pacific Tea Co. v. Supermarket Corp.*, 340 U. S. 147?

QUESTION 6.

The Supreme Court has NOT rendered ANY decision since *Great Atlantic & Pacific Tea Co. v. Supermarket Corp.*, 340 U. S. 147, HOLDING whether or not a patent having (a) A NEW ELEMENT, (b) A NEW MODE OF OPERATION, or (c) A "SURPRISINGLY" NEW RESULT is "outside" of the ruling in the *Great Atlantic & Pacific Tea Co.* case, *supra*, and SUCH A DECISION SHOULD BE MADE BY THIS COURT.

Reasons Relied Upon for the Allowance of the Writ of Certiorari.

The discretionary power of this Court is invoked upon the following grounds:

1. That the Court of Appeals for the Ninth Circuit in holding the new combinations of NEW and old ELEMENTS, having a NEW MODE OF OPERATION, and producing "SURPRISINGLY" NEW RESULTS that are claimed in Claims 1 and 2 of Patent No. 2,403,597 are not "inventions" but instead are "aggregations" has rendered a decision in direct conflict with the dicta of this Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Corporation*, 340 U. S. 147. (Rule 38, Section 5(b), of the Rules of this Court.)

2. That the above decision of the Court of Appeals for the Ninth Circuit is in direct conflict with its own decision in *Photochart v. Photo Patrol*, 189 F. 2d 625, 627, and with the decisions of the Courts of Appeal for the Fifth, Eighth, Sixth, Tenth and Fourth Circuits in *E-I-M Co. v. Philadelphia Gear Works*, 205 F. 2d 23, 30 5th C. A.); *Jeoffroy Mfg. Co. v. Graham*, 206 F. 2d 772,

777 (5th C. A.); *Aeration Processes v. Lange,* 196 F. 2d 981, 983 (8th C. A.); *United Specialties Co. v. Industrial Corp.,* 186 F. 2d 428, 429 (6th C. A.); *Oliver United Silvers Corp. v. Silver,* 206 F. 2d 658, 663 (10th C. A.), and *Ingersoll-Rand Co. v. Black & Decker Mfg. Co.,* 192 F. 2d 270, 273 (4th C. A.). (Rule 38, Section 5(b), of the Rules of this Court.)

3. That the above decision of the Court of Appeals for the Ninth Circuit is in direct conflict with the decisions of the district courts in *Artmoore v. Dayless Mfg. Co.,* 109 Fed. Supp. 181; and *Interstate Rubber Products Corp. v. Radiator Specialty Co.,* 114 Fed. Supp. 120, and the Supreme Court should settle this conflict under its powers of supervision before a greater Court of Appeals conflict arises out of this conflict.

4. That issues of great moment to the public are involved because if the above decision of the Court of Appeals for the Ninth Circuit is finally permitted by this Court to stand, it might constitute a holding that the doctrine of the *Great Atlantic & Pacific Tea Co. v. Supermarket Corp.,* 340 U. S. 147, is extended far beyond the intention of this Court in that case, namely, it might constitute a holding that a combination claim is invalid as an "aggregation" lacking "invention" even though the combination is NEW and it has a NEW ELEMENT, or it has a NEW MODE OF OPERATION, or it has a "SURPRISINGLY" NEW RESULT; and such an extension of the doctrine of the *A & P* case, *supra,* would have a disastrous effect on many industries protected by patents that are now deemed valid under the present interpretation of said case by most Courts of Appeal. (Rule 38, Section 5(b), of the Rules of this Court.)

5. That the above issues of great moment to the public involved, might otherwise never be settled by this Court because further litigation which might result in conflict between Circuit Courts of Appeal on this (Hillgren) patent in suit might not ever reach this (Supreme) Court for the reason that, even though the Petitioner won in another District Court and won in another Court of Appeal, the Petitioner WOULD HAVE NO RIGHT TO PETITION THIS COURT IN THAT CASE BECAUSE HE WOULD BE THE WINNER (APPELLEE), AND IT WOULD THEN BE TOO LATE FOR PETITIONER TO PETITION THIS (SUPREME) COURT IN THIS (KWIKSET) CASE, THE TIME HAVING LONG SINCE THEN ELAPSED, and the Appellant in that case might not apply for a writ of certiorari and Petitioner COULD NOT MAKE HIM DO SO, and, under such circumstances, the public would not have the opportunity of receiving the benefit of a decision of this (Supreme) Court on the issues of great moment listed above. Therefore THIS IS PETITIONER'S ONLY RIGHT TO PETITION THIS COURT ON THESE ISSUES OF GREAT PUBLIC MOMENT ON THE GROUND OF CONFLICT OF DECISIONS BETWEEN Circuit Courts of Appeal and the DICTA of this Court on this (Hillgren) patent. (Rule 38, Section 5(b), of the Rules of this Court.)

6. That the above holding of the Court of Appeals for the Ninth Circuit in this case that the NEW ELEMENTS, NEW MODE OF OPERATION and "SURPRISINGLY" NEW RESULTS of Claims 1 and 2 of the Hillgren Patent No. 2,403,597 do not constitute invention, is so inconsistent on its face as to constitute

such a departure from the accepted and usual course of judicial proceedings as to call for the exercise of this Court's power of supervision. (Rule 38, Section 5(b), of the Rules of this Court.)

For the foregoing reasons, it is respectfully submitted that this petition for a writ of certiorari should be granted.

HAMER H. JAMIESON,
Attorney for Petitioner.

State of California, County of Los Angeles—ss.

Hamer H. Jamieson, being duly sworn, deposes and says:

That he is the attorney for the Petitioner herein, that he prepared the foregoing Petition, and that the allegations thereof are true, as he verily believes.

HAMER H. JAMIESON.

Subscribed and sworn to before me this 16th day of April, 1954.

(Seal)

JERRY JAMIESON,
Notary Public.

IN THE

Supreme Court of the United States

October Term, 1953

No. .....

CARL A. HILLGREN,

Petitioner,

vs.

KWIKSET LOCKS, INC., ADOLPH SCHOEPE and KARL REINHARD,

Respondents.

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

The Opinions of the Courts Below.

The District Court, in its judgment of May 21, 1951 [R. pp. 31-35], held Claims 1 and 2 of the Hillgren patent in suit No. 2,403,597 to be infringed and to be valid, having many named new functions and results. [R. pp. 22-25.] Also it has new elements and a new mode of operation, as is fully shown hereinafter.

The Court of Appeals (100 U. S. P. Q. 289, February 3, 1954) (9th Cir.), reversed the District Court and held the patent claims invalid as constituting an "aggregation" under its erroneous interpretation and misapplication of the decision of this (Supreme) Court's ruling in *Great Atlantic & Pacific Tea Co. v. Supermarket Corp.*, 340 U. S. 147.

This petition is to reverse the Court of Appeals on the ground that:

1. The facts herein show that the "claims in issue"
   a. Include one or more NEW ELEMENTS.
   b. Have a NEW MODE of OPERATION.
   c. Accomplish a "SURPRISINGLY" NEW RESULT.

2. The law is that under any of these three circumstances a combination patent claim is NOT invalid for lack of "invention" or "aggregation" under *A & P v. Supermarket Corp.*, 340 U. S. 147, *supra*.

Jurisdiction.

The grounds for jurisdiction are:

1. The Decision of the Court of Appeals was first rendered on March 16, 1953. (97 U. S. P. Q. 206.) Petitioner's petition for rehearing was granted by the Court of Appeals on April 28, 1953, and, at the same time, the decision of March 16, 1953, was withdrawn by the Court of Appeals. The oral rehearing was held on November 20, 1953. The opinion of the Court of Appeals was then virtually re-entered on February 3, 1954 (100 U. S. P. Q. 289) [R. pp. 898-914], substantially repeating the opinion after the rehearing, thus in effect denying the rehearing. The decree of the Court of Appeals pursuant to its above opinion of February 3, 1954, was entered at the same time.

2. The Decree was entered in a suit in equity brought under the patent statutes to determine the issues of validity and infringement of Letters Patent issued by virtue of Revised Statute No. 4886 (35 U. S. C. 31).

3. The statute under which the jurisdiction of this Court is invoked is Title 28, United States Code, Section 1254.

4. The cases believed to sustain the jurisdiction are:

United Carbon Co. v. Binney & Smith Co., 317 U. S. 228, 87 L. Ed. 232;

Schriber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211, 85 L. Ed. 132, 135;

Mackay Radio & Telegraph Co. v. Radio Corp. of America, 306 U. S. 86, 89, 83 L. Ed. 506, 508;

Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147;

Photochart v. Photo Patrol, 189 F. 2d 625, 627 (9th C. A.);

E-I-M Co. v. Philadelphia Gear Works, 205 F. 2d 28, 30 (5th C. A.);

Jeoffroy Mfg. Co. v. Graham, 206 F. 2d 772, 777 (5th C. A.);

Aeration Processes v. Lange, 196 F. 2d 981, 983 (8th C. A.);

United Specialties Co. Case, 186 F. 2d 428, 429 (6th C. A.);

Oliver United Silvers Corp. v. Silver, 206 F. 2d 658, 663 (10th C. A.);

Ingersoll-Rand Co. v. Black & Decker Mfg. Co., 192 Fed. 270, 273 (4th C. A.);

Artmoore v. Dayless Mfg. Co., 109 Fed. Supp. 181;

Interstate Rubber Products Corp. v. Radiator Specialty Co., 114 Fed. Supp. 120.

Statement.

The facts are stated in the Petition.

Statutes.

The statutes under which this case arises which are necessary to be considered here are as follows:

Revised Statute, Section 4886 (U. S. C., Title 35, Sec. 31):

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvement thereof, . . . not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before the invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Specification of Errors.

The errors which Petitioner will urge if the writ of certiorari is allowed, are that the Court of Appeals for the Ninth Circuit erred:

1. In reversing the Decree of the District Court holding the Hillgren Patent No. 2,403,597 valid and infringed by respondents.

2. In failing to hold the Hillgren Patent No. 2,403,597 to be valid.

3. In failing to hold the Hillgren Patent No. 2,403,597 to have been infringed by respondents.

4. In failing to hold that the law established by the decision of this (Supreme) Court in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U. S. 147, was not controlling or dispositive of this litigation because this litigation is distinguished on the facts from said case for the reason that the Hillgren Patent in suit No. 2,403,597 contains one or more new elements, has one or more new modes of operation or produces one or more "surprisingly" new results not found in the prior art.

5. The Court of Appeals erred in finding that Petitioner "agreed" that the deadlatch mechanism of the Hillgren patent in suit "is to be found in the prior art." [R. pp. 906 and 901.]

6. The Court of Appeals erred in finding that the deadlatch mechanism of the Hillgren patent in suit "is to be found in the prior art." [R. pp. 906, 901.]

7. The Court of Appeals erred in finding that "Beyond the application of the deadlatch principle to the reverse rocker type lock, no novelty is shown by the exhibits or record, nor in the finding of the Court." [R. p. 906.]

8. The Court of Appeals erred in finding that "the District Court was clearly wrong in concluding that the Hillgren combination is patentable." [R. p. 906.]

9. The Court of Appeals erred in finding that the Hillgren patented combination "accomplishes no more than the sum of its parts." [R. p. 906.]

10. The Court of Appeals erred in finding that the District Court committed reversible error in sustaining

Hillgren's "Door lock" patent on the erroneous ground that in so doing it failed to apply the strict standard for testing combination patents which was laid down by the Supreme Court in *Great A & P Tea Co. v. Supermarket Equipment Corp., supra.*" [R. pp. 907-908.]

11. The Court of Appeals erred in finding that the Hillgren deadlatch mechanism is old, and not new.

12. The Court of Appeals erred in finding that the Hillgren deadlatch sub-combination is the same as the Schlage deadlatch sub-combination.

13. The Court of Appeals erred in failing and refusing to find that the Hillgren patent is a new combination of some old and some NEW ELEMENTS and therefore that it constitutes invention over the prior art.

14. The Court of Appeals erred in failing and refusing to find that the Hillgren combination has a NEW MODE OF OPERATION, not found in the prior art, and that therefore the Hillgren combination constitutes invention over the prior art.

15. The Court of Appeals erred in failing and refusing to find that the Hillgren combination has a "SURPRISINGLY" NEW RESULT, not found in the prior art, and that therefore the Hillgren combination constitutes invention over the prior art.

16. The Court of Appeals erred by erroneously deciding an important question of Federal law which has not been, but should be, settled by the Supreme Court. (Rule 38, Section 5(b), of the Rules of the Supreme Court.)

17. The Court of Appeals erred by erroneously deciding a Federal question in a way probably in conflict with applicable decisions of this Court. (Rule 38, Section 5(b), of the Rules of the Supreme Court.)

18. The Court of Appeals erred because it has so far departed from the accepted and usual course of judicial proceedings as to call for an exercise of the power of supervision of the Supreme Court. (Rule 38, Section 5(b), of the Rules of the Supreme Court.)

Summary of Argument.

The points of the argument restate the reasons relied upon for the allowance of the writ of certiorari, *supra*, and may be summarized as follows:

POINT I. INVENTION IS THE SOLE ISSUE.

POINT II. THE LAW AND FACTS INVOLVED.

1. INVENTION IS A QUESTION OF LAW TO BE FINALLY REVIEWED BY THE SUPREME COURT.
2. THE LAW OF SOME COURTS OF APPEAL, AND THE DICTA OF THE SUPREME COURT, IS THAT "INVENTION" IS PRESENT IN ANY NEW COMBINATION THAT HAS
   a. A NEW ELEMENT
   b. A NEW MODE OF OPERATION
   c. A "SURPRISINGLY" NEW RESULT.

3. "INVENTION" IS, THEREFORE, PRESENT IN THE HILLGREN NEW COMBINATION BECAUSE IT HAS IN FACT:

   a. THREE NEW ELEMENTS:

      (1) A NEW DOG

      (2) A NEW DOGGING SUBCOMBINATION

      (3) A NEW OPERATING MEMBER.

   b. TWO NEW MODES OF OPERATION:

      (1) THAT SURROUNDING THE DOG.

      (2) THAT SURROUNDING THE OPERATING MEMBER.

   c. SEVEN "SURPRISINGLY" NEW RESULTS (See APPENDIX D):

      (1) WORLD'S FIRST DEADLATCHED REVERSE ROCKER TYPE LOCK.

      (2) A NEW FUNCTION, DEADLOCKING, IS ADDED TO REVERSE ROCKER TYPE LOCKS.

      (3) DEADLOCKING MECHANISM INCORPORATED IN THE MIDST OF A REVERSE ROCKER TYPE LOCK.

(4) NUMBER OF PARTS REDUCED TO LESS THAN ONE-THIRD. [R. pp. 628-634.]

(5) NUMBER OF MACHINING OPERATIONS REDUCED TO LESS THAN ONE-FOURTH. [R. pp. 570-574.]

(6) QUANTITY PRODUCTION OF 14,400 LATCHES PER DAY ACHIEVED BY THE HILLGREN INVENTION. [R. pp. 581-582.]

(7) IT IS IMPOSSIBLE TO COMBINE PRIOR ART REVERSE ROCKER TYPE LOCKS WITH PRIOR ART DIRECT ACTION TYPE DEADLATCHES SO HILLGREN'S NEW ELEMENT—HIS NEW DOG OR DEADLATCH SUBCOMBINATION SOLVED A THERETOFORE INSOLVABLE PROBLEM BY THE INVENTION OF A NEW ELEMENT.

ARGUMENT.

POINT I.

Invention Is the Sole Issue.

The SOLE ISSUE now remaining in this case is the VALIDITY of the patent in suit from the standpoint of INVENTION.

Title in Petitioner, and infringement by Respondents, were both found by the District Court [R. pp. 21-23, 31-33] and are no longer in issue; and novelty and utility were found by the District Court [R. pp. 21-23, 25-32], and were conceded by Respondents [R. pp. 453, 469, 471], so that they are likewise not in issue now.

Invention is not only the sole issue [R. p. 471], but, in turn, the issue of invention itself has been narrowed down to invention over two prior art patents, namely, Baume and Schlage [Rep. Tr. pp. 495, 499-500, 452-453, 472, 483, 495, 496, 500, 510 and 511], under the rule in a single case, namely, *Great Atlantic and Pacific Tea Co. v. Supermarket Corp.*, 340 U. S. 147. [R. pp. 907-908.]

The Petitioner and the District Court hold that the patent in suit is an INVENTION, consisting of a NEW combination of NEW and old elements, having a NEW MODE OF OPERATION and accomplishing a "SURPRISINGLY" NEW RESULT.

The Respondents and the Court of Appeals contend that it is not an invention.

POINT II.

The Law and Facts Involved.

The cast of *Great A & P Tea Co. v. Supermarket Equip. Corp.*, 340 U. S. 147, relied upon SOLELY by the Court of Appeals in its decision in this case, established two rules:

1. All questions of INVENTION may be reviewed by the Supreme Court in ALL patent cases in which INVENTION is an issue because INVENTION is a question of CONSTITUTIONAL LAW (NOT a question of FACT, as was formerly the rule). (Concurring opinion of Justice DOUGLAS.)

2. A specific nolding that the new combination of elements in that case is invalid as an "aggregation" lacking "invention" because it did not have one of the following:

   (a) A new element,

   (b) A new mode of operation, or

   (c) A "surprisingly" new result.

This latter holding CLEARLY constitutes DICTA, by way of negative inference, that if a NEW combination DOES have any ONE of the above three characteristics it WILL constitute an EXCEPTION to the rule in the *A & P Tea Co.* case, *supra.*

As far as Petitioner has been able to find, and he has read all of the FIVE (5) COLUMNS of the cases cited in Shepard under the *A & P Tea Co.* case, *supra,* the Supreme Court has NOT yet DECIDED any case on the specific issue of any one of the above three exceptions to the above rule.

In other words, the Supreme Court has NOT yet HELD in any case since the *A & P Tea Co.* case, *supra,* that any patent in suit was VALID (or INVALID) because it HAD any one of these three exceptions to the rule in its combination.

However, since the decision in the *A & P Tea Co.* case, *supra,* many Courts of Appeal and some District Courts have SPECIFICALLY HELD many patents to be VALID INVENTIONS, and "outside" of, or an exception to, the rule in the *A & P Tea Co.* case, *supra,* because they contained one of these three exceptions in their respective combination.

The details of the law and the above Lower Court decisions defining these three exceptions to the above rule that was promulgated in the *A & P Tea Co.* case, *supra,* and some pertinent excerpts from the record in this case which show that this case is well within these exceptions are set forth in an appendix hereto, and are summarized below under the above headings, in the above order.

(a) A NEW ELEMENT.

A. The Law.

Dicta in the *A & P Tea Co.* case, *supra,* and decisions in other cases cited below and excerpted in "APPENDIX A," accompanying this brief, under Rule 35 of the Supreme Court, and for the convenience of the Court, show that this Court should grant this Writ in order to complete the work of promulgating the law of this subject that this Court commenced in the *A & P Tea Co.*

case, *supra*, by promulgating the following rule in this case:

A NEW combination containing a NEW ELEMENT and producing a new and beneficial result is a VALID INVENTION.

A & P Tea Co. v. Supermarket Corp., 340 U. S. 147, 148, 149, 152;

Photochart v. Photo Patrol, 189 F. 2d 625, 627 (9th C. A.);

E-I-M Co. v. Philadelphia Gear Works, 205 F. 2d 28, 30 (5th C. A.);

Jeoffroy Mfg. Co. v. Graham, 206 F. 2d 772, 777 (5th C. A.);

Guiberson Corp. v. Garrett Oil Tools Inc., 205 F. 2d 660, 662 (5th C. A.);

Aeration Processes v. Lange, 196 F. 2d 981, 983 (8th C. A.);

Artmoore v. Dayless Mfg. Co., 109 Fed. Supp. 181, 183, 184.

B. The Facts.

The Hillgren NEW combination IN FACT contains a NEW ELEMENT.

This was conclusively PROVEN herein in the record, a few pertinent parts of which are summarized below.

The Hillgren NEW combination IN FACT contains not only one NEW ELEMENT, but THREE NEW ELEMENTS, namely:

1. A NEW DOG,
2. A NEW DOGGING SUB-COMBINATION, and
3. A DUAL-FUNCTION OUTWARDLY-SLIDING OPERATING MEMBER.

These THREE NEW ELEMENTS will be summarized in that order:

1. A NEW DOG.

Hillgren's NEW DOG, 16, a separate COURT OF APPEALS EXHIBIT in this case, has two NEW CHARACTERISTICS:

a. It is pivoted at its inner end.

b. It is actuated NEAR its pivoted end.

These two characteristics are SPELLED OUT and INCLUDED as LIMITATIONS in Hillgren's Claim 2, in issue herein.

These characteristics CAUSE THE FREE END of the Hillgren dog to MOVE MORE THAN TWO TIMES AS FAST as the outwardly sliding operating member 13 which supplies ALL of the actuating force for BOTH the dog 16 and the main latch 11.

This is what enables the free end of the Hillgren dog to get out of the way of the main latch, because, if it did not, the latch would not work. [R. pp. 86, 417.]

It was PROVEN and stated MANY TIMES IN THE RECORD that this element is NEW! [R. pp. 157, 158, 159, 160, 161, 177, 109, 110, 655, 656.]

Also it was PROVEN many times in the record that there is NO DOG LIKE HILLGREN'S IN THE PRIOR ART.

It was, for instance, shown, time without number, that the CLOSEST REFERENCE among all of the prior art dogs is the dog shown in Figure 10 of Schlage, Exhibit No. 34, Patent No. 2,250,727 [R. pp. 495, 499-500, 452-453, 472, 483, 495, 496, 500 and 510-511].

Also Respondents conceded, and the Court found that Hillgren (including his dog) is NEW. [R. pp. 453, 469, 471, 21, 22; 23—finding 6; 24, 25—findings 12 and 13; 27—finding 15; 29—findings 2; 32.]

Hillgren's DOG 16 is, therefore, NEW! Also it is ENTIRELY DIFFERENT from the Schlage dog shown in Figure 10 of Exhibit 34.

The accompanying illustrative drawings show CLEARLY that Hillgren's dog is ENTIRELY DIFFERENT, from the Schlage dog, as Petitioner will now point out:

Preliminary Explanation.

The record [R. pp. 145-146] shows clearly that the main latch 11 in Hillgren moves two times as fast as the outwardly sliding operating member that actuates BOTH the main latch and the Hillgren dog.

This is due to the reverse rocker mechanism.

Any deadlatch for it must therefore move AT LEAST FASTER than two times as fast as the operating member that actuates it and NO PRIOR ART DOG CAN DO THIS. NO PRIOR ART DOG COULD GET OUT OF THE WAY OF A REVERSE ROCKER ACTUATED MAIN LATCH.

Only Hillgren's dog (and Kwikset's infringing copy) can do this, as these drawings CLEARLY SHOW:

Description of Illustrative Drawings.

Turning now to the accompanying illustrative drawings, there are three sets, each having three views, namely:

Figure I shows the Hillgren NEW DOG in THREE positions:

(a) DOG CLOSED (Figure 8 of patent in suit No. 2,403,587).

(b) KNOB 6 and SPINDLE 4 turned toward OPEN position JUST 6½°.

(c) KNOB 6 and SPINDLE 4 turned toward OPEN POSITION 25°.

Figure II shows the Schlage dog (Fig. 10 of Schlage No. 34, No. 2,250,727) in the same three positions.

Figure III shows a combined Schlage-Baume lock in the same three positions, with the SINGLE EXCEPTION that the THIRD position shows the knob and spindle turned toward open position ONLY 12° BECAUSE IT JAMS at that position and CANNOT open any farther.

These figures are illustrative, and are largely SELF-EXPLANATORY, but they will now be briefly described in detail and applied to the present issues:

FIGURE I.

Figure Ia.

Figure Ia is like Figure 8 of the patent in suit, showing the knob 6 and spindle 4 at normal rest position.

DOG 16 is pivotally mounted at its inner end 16a and its FREE outer end or tip, marked 16t is in its dogging position directly above shoulder 11d on main latch 11. Obviously if main latch 11 was moved inwardly by hostile action shoulder 11d of latch 11 would contact free end 16t of dog 16 and further retraction of latch 11 would be arrested, thus illustrating the "deadlatch" operation.

Bead 13e on operating member 13 may be made as shown in solid lines (like the Hillgren commercial embodiment of Exhibit 2 [R. p. 49]), or as shown in Figures 2 and 8 of the patent in suit, namely, with the cross-hatched stock 13z of Figure I removed.

Bead 13e is in contact with inclined face 16c of dog 16, ready to go into operation whenever operating member 13 is actuated by rotation of knob 6.

Figure Ib.

In Figure Ib knob 6 and spindle 4 have been turned 6½°.

This slight turning movement has rotated dog 16 about pivot 16a sufficiently to cause free end 16t of dog 16 to move completely out of the path of shoulder 11d on main latch 11.

The distance B (or the radius from pivot 16a to free end 16t of dog 16), is 2½ times the distance A (or the radius from pivot point 16a to the point of contact between bead 13e on operating member 13 with inclined face 16c of dog 16). This ratio of A to B of 2½ times means that point 16t MOVES 2½ TIMES as fast as operating member 13.

Since main latch 11 moves TWICE as fast as operating member 13, as noted above (because rocker arm 15b is TWICE as long as rocker arm 15a of rocker 15 [R. pp. 145-146, *supra*]) and free end 16t MOVES MORE THAN TWICE (2½ times) as fast as operating member 13, this relation causes free end 16t to move FASTER than main latch 11 so as to get out of the way of shoulder 11d, on latch 11, as shown in Figure Ib in a minute turn, namely, 6½°, of knob 6.

Figure Ic.

Further rotation of knob 6, namely, a total of ONLY 25°, MOVES free end 16t of dog 16 COMPLETELY out of the path NOT ONLY of shoulder 11d BUT of THE

ENTIRE MAIN LATCH 11, as is seen clearly in Figure Ic.

This is accomplished by the outward sliding of operating member 13 and its bead 13e which has slid down inclined face 16c of dog 16 from the position shown in Figure Ia to the position shown in Figure Ic.

Thus Figure Ic shows the Hillgren dog 16 COMPLETELY undogged by only a 25° turn of knob 6, before main latch 11 has been completely retracted, AND BEFORE THERE IS ANY DANGER OF FREE END 16t BEING JAMMED BEHIND SHOULDER 11d, OR ANY OTHER PART OF MAIN LATCH 11.

THUS Figures Ia, Ib and Ic ILLUSTRATE NOT ONLY HILLGREN'S NEW ELEMENTS (his NEW DOG, his NEW DOGGING SUB-COMBINATION, and his NEW OPERATING MEMBER), but also they illustrate HILLGREN'S NEW MODE OF OPERATION and NEW RESULTS, described elsewhere herein.

Figure II.

Figure IIa.

Figure IIa shows the Schlage dog of Figure 10 of Schlage Exhibit No. 34, Patent No. 2,250,727, in the position of Figure 2 of that patent, with knob 4a and spindle 7 in normal rest position.

Dog D is NOT pivoted at its inner end De, but, instead is pivoted at a bend in its body at Dp. (For "DOG PIVOT.")

Main latch 12 moves as a unit with "Figure 5" (of Patent No. 2,250,727) and with its shoulder 24 (which engages "dog 47" on Schlage's dog D if it is not moved

out of the way) as well as with "Figure 6" (of Schlage patent).

Slanting surface 29 on "Fig. 6" engages slanting surface 46 on Dog D.

ALL parts move INWARDLY on a 1 to 1 ratio.

Figure IIb.

Rotation of knob 4a 6½° pulls "Fig. 6" INWARDLY, forcing its slanting surface 29 against slanting surface 46 of dog D to partially undog the dog D by this camming action.

Figure IIc.

Rotation of knob 4a through 25° causes slanting surface 29 of "Figure 6" to move INWARDLY completely clear of slanting surface 46 of dog D and at the same time moves dog 47 out of the path of "Figure 5" to complete the undogging by a 1 to 1 ratio, all parts moving at ABOUT THE SAME RATE OF SPEED.

It should be noted that the undogging force is applied in Schlage at 46 WHICH IS NEAR ITS FREE END and NOT NEAR its pivot Dp or its INNER END De.

This causes the Schlage free end 46 to move at a ratio of 1 to 1 with its MOTIVATING FORCE, MEMBER 29, INSTEAD of at the 2½ TO 1 ratio shown above between Hillgren's free end 16t of his dog 16 and his motivating force, member 13.

FIGURE III.

Figure IIIa.

This shows a Schlage device exactly like Figure IIa, except that it is ASSUMED that a reverse rocker mechanism like Baume, No. 29, Patent No. 1,880,675, has in some manner (not shown or KNOWN) been op-

eratively inserted BETWEEN SCHLAGE'S MAIN LATCH 12, and a SEPARATE OUTWARDLY moving operating member (NOT SHOWN), thus necessitating TWO operating members, one moving INWARDLY to operate the Schlage deadlatch, and a second, separate, operating member moving OUTWARDLY to actuate main latch 12 (which is all that Baume shows or teaches).

This means that a 1 to 2 ratio has now been set up between two groups of Schlage's parts, namely, the "single-speed group" comprising parts 4a, 7, "Fig. 6," 29, D. 47 and 46, and the "double-speed group," that moves TWICE as fast as the "single-speed group," due to the reverse rocker mechanism, and that comprises parts "Fig. 5," 24, and 12.

In short, the reverse rocket speed-up to 2 to 1 ratio acts on the main latch, 12, its shoulder, 24, and its connecting link, "Fig. 5," which is now separated from "Fig. 6" (which moves at "single-speed").

Figure IIIb.

This figure shows the mechanism of Figure IIIa moved by the rotation of knob 4a through a turn of 6½°.

Comparison of Figure IIIb with Figure IIb shows that the main latch 12 has moved TWICE as far, due to the action of the reverse rocker mechanism (not shown).

The dog is still NOT undogged.

Figure IIIc.

Here the knob 4a has been moved only a total of 12° (NOT 25°), and the lock has become completely JAMMED and INOPERATIVE because main latch 12 has moved twice as fast as operating member "Figure 6," and dog 47 has not moved fast enough to get out of the way of inwardly moving shoulder 24 on main latch 12.

As a result shoulder 24 on main latch 12 is hopelessly jammed up against the lower end of dog 47 and the lock cannot work and it is not possible to open the door.

This was predicted by all of the experts at the trial. [R. pp. 86, 417.]

Summary.

Thus it is seen that:

a. Schlage will not work with Baume because Schlage is a single-speed, direct action, type dog and it is PHYSICALLY IMPOSSIBLE for it to get out of the way of a double-speed, reverse rocker actuated main latch.

b. Hillgren has the ONLY MORE THAN DOUBLE-SPEED dog—the ONLY dog that can get out of the way of a DOUBLE-SPEED reverse rocker actuated main latch.

Therefore, Hillgren's DOG is a NEW ELEMENT.

For the convenience of the Court a tabulation of the roughly comparable parts of Hillgren and Schlage and the rate of speed (single (1) or double (2)) of the parts in Figure III is as follows:

Hillgren		Schlage	Rate of Speed
4	spindle	7	(1)
6	knob	4a	(1)
13	operating member	"Fig. 6"	(1)
13e	bead	29	(1)
16	dog	D	(1)
16c	dog cam	46	(1)
16t	dog tip	47	(1)
11	main latch	12	(2)
11	extension of main latch	"Fig. 5"	(2)
11d	shoulder on main latch	24	(2)

ANOTHER REASON why Hillgren's DOG is a NEW ELEMENT is because Respondents admitted that their CLOSEST REFERENCE, the Schlage dog, COULD NOT BE INSERTED IN A REVERSE ROCKER TYPE LOCK (such as Baume 34), AND WORK. [R. pp. 526, 527, 523.]

Instead, the Patent Office [R. pp. 474-475] and Respondents [R. pp. 486, 523] admitted that the Schlage dog would have to be "ENTIRELY RECONSTRUCTED" to even work in Baume or any other reverse rocker type lock. [R. pp. 473-475, 486, 512-531.]

Petitioners showed by their expert, VERNON BEEHLER, a most competent Patent lawyer, that the Schlage dog could not be made to work in Baume, NO MATTER HOW MUCH "RECONSTRUCTION" WAS TRIED. [R. pp. 644, 614, 640.]

The District Court ruled that Respondents' expert, Hackstaff, had admitted that HE could not make the Schlage dog work in Baume. [R. p. 527.]

Therefore, since the Hillgren dog receives its power near its PIVOTED end and thereby its free end moves more than TWO times as fast as the source of its power, due to ITS lever construction, whereas the Schlage dog receives its power NEAR ITS FREE end and so moves ONLY as fast as its source of power, THE CONCLUSION IS inevitable that THE HILLGREN DOG IS A NEW ELEMENT.

(2) A NEW DOGGING SUB-COMBINATION.

Not only is Hillgren's DOG NEW, but Hillgren's DOGGING SUB-COMBINATION is also NEW.

The Hillgren dogging sub-combination includes the PARTS that are associated with the dog in its mode of

operation, namely, BEAD 13e on the outer end of operating member 13 (which engages inclined face 16c near the inner end of the dogging members 16); SHOULDER 2b of the housing member 2 (which holds the inner end of the dogging member in position and receives the pivot point 16a of the dogging member, as is seen clearly in Figure 8 of the patent in suit) and COMPRESSION SPRING 17 (which "adapts" the dogging member to be shifted by the movement of the auxiliary latch member, with its free end into dogging engagement with the inner end of the main latch member), as the claims state.

This dogging sub-combination is also NEW and is NOT found anywhere in the prior art. This sub-combination is included as a limitation in the claims of the patent in suit, so it also constitutes a NEW element in the NEW combination of NEW and old elements that is shown in Claims 1 and 2 of the patent in suit.

(3) A DUAL-FUNCTION OUTWARDLY-SLIDING OPERATING MEMBER.

This third NEW ELEMENT in the Hillgren NEW combination was described by Petitioner's witness BEEHLER. [R. pp. 83, 85-86.]

It was also CONCEDED by Respondents' Counsel. [R. pp. 67-69.]

This NEW element consists of operating member 13, bead 13e on member 13 and shoulder 13b on member 13.

It performs two functions:

(1) Bead 13e unlatches the dog by pressing against it NEAR ITS PIVOTED END to move the free end of the dog out of the way of the main latch 11.

(2) Shoulder 13b then actuates rocker arm 15a to retract main latch 11 through reverse rocker 15.

NO prior art operating member moves OUTWARDLY to perform these two functions and there is NO PRIOR ART OPERATING MEMBER LIKE Hillgren's member 13 with its BEAD 13e and SHOULDER 13b.

THEREFORE this THIRD Hillgren element is ALSO a NEW ELEMENT.

Thus Petitioner has shown that his combination in suit has not only ONE but THREE NEW ELEMENTS, namely:

1. A NEW DOG.
2. A NEW DOGGING SUB-COMBINATION.
3. A DUAL-FUNCTION OUTWARDLY SLIDING OPERATING MEMBER.

The new and beneficial results are shown hereinafter under section (c) "SURPRISINGLY NEW RESULTS."

Therefore, on this ground alone, namely, presence of a NEW ELEMENT, the Hillgren NEW combination is a VALID INVENTION.

(b) A NEW MODE OF OPERATION.

A. The Law.

Decisions of some Courts of Appeal and dicta of the Supreme Court in the *A & P Tea Co.* case, *supra,* cited below and excerpted in "APPENDIX B," accompanying this brief, under Rule 35 of the Supreme Court, and for the convenience of this Court, show that this exception to the rule in the *A & P Tea Co.* case, *supra,* which has NOT yet been at issue in a DECISION of the Supreme

Court, but IS at issue now in this case, should be promulgated by making the following rule in this case:

A NEW combination containing a NEW MODE OF OPERATION and producing a new and beneficial result is a VALID INVENTION.

A & P Tea Co. v. Supermarket Corp., 340 U. S. 147, 151;

United Specialties Co. v. Industrial etc. Corp., 186 F. 2d 426, 429 (6th C. A.);

Oliver United Silvers Corp. v. Silver, 206 F. 2d 658, 663 (10th C. A.).

B. The Facts.

The Hillgren NEW combination IN FACT contains a NEW MODE OF OPERATION.

This was fully ESTABLISHED in the record in this case, and some pertinent parts thereof proving this are summarized below.

The Hillgren NEW combination has not only ONE, but TWO NEW MODES OF OPERATION, that may be succinctly referred to as:

(1) That surrounding the dog, and

(2) That surrounding the operating member,

and they will be summarized below in that order.

(1) THE NEW MODE OF OPERATION SURROUNDING THE NEW HILLGREN DOG.

This NEW MODE OF OPERATION is described by Petitioner's witness VERNON D. BEEHLER at pages 636, 637, of the record.

Also, it is described in the patent in suit at col. 4, lines 16 to 32, inclusive.

It may be succinctly summarized as follows:

THE DOGGING MEMBER is pivotally mounted in the inner end of the lock cylinder and is actuated into rotary movement on its pivotal mounting by the outwardly sliding operating member contacting the dogging member near its pivoted end and thereby actuating the outer end of the dogging member in a direction transverse to the direction of movement of the main latch bolt, and this actuation of the outer end of the dogging member is soon enough and fast enough to move the outer end of the dogging member out of the way of the main latch when it is thereafter retracted by the further outward movement of the operating member.

This mode of operation is NEW because it is NOT FOUND ANYWHERE IN THE PRIOR ART.

(2) THE NEW MODE OF OPERATION SURROUNDING THE NEW HILLGREN OPERATING MEMBER.

This NEW MODE OF OPERATION is described and shown to be "NEW," by Petitioner's witness VERNON D. BEEHLER at pages 83-86, 93-94, 141-142, 149, 150, 154, 157-161, 176, 417, 633, of the record.

It is also described and conceded by Respondents' Counsel at pages 67-69 of the record.

Finally, it is described in the patent in suit at col. 2, line 39, through col. 4, line 32.

It may be briefly summarized as follows:

THE NEW Hillgren OPERATING MEMBER slides outwardly and its bead 13e presses against oblique cam face 16c on the NEW Hillgren dogging member, 16, rotating it counter-clockwise out of the path of shoulder 11d of main latch 11, then further outward sliding movement of the NEW Hillgren operating member 13 causes an end 13b of the NEW Hillgren operating member 13 to press against an arm 15a of the rocker 15, causing rocker 15 to rotate counter-clockwise, which makes the other end 15b of the rocker 15 move an end of latch 11 inwardly so that latch 11 is withdrawn and the door can be opened.

Mr. Beehler testified (at the above places in the record) that this MODE OF OPERATION is NEW because it is NOT FOUND ANYWHERE IN THE PRIOR ART.

NO ONE PRODUCED BY RESPONDENTS COULD FIND THIS MODE OF OPERATION IN THE PRIOR ART. THIS NEGATIVE FACT FURTHER SHOWS AND PROVES THAT THIS MODE OF OPERATION IS NEW.

The Hillgren new and beneficial results are set forth in the next section of this brief.

Therefore, Petitioner respectfully submits that, on this second, separate, ground, namely, a NEW MODE OF OPERATION, the Hillgren NEW combination is a VALID INVENTION.

(c) A "SURPRISINGLY" NEW RESULT.

A. The Law.

Dicta by the Supreme Court in the *A & P Tea Co.* case, *supra,* and decisions of some Lower Courts, cited below and excerpted in "APPENDIX C," accompanying this brief, under Rule 35 of the Supreme Court, and for the convenience of this Court, show that this exception to the rule in the *A & P Tea Co.* case, *supra,* which should be promulgated (because it is at issue) in this (Hillgren) case by the Supreme Court, via the prayed-for Writ of Certiorari herein, may be stated as follows:

A NEW combination that produces a "SURPRISINGLY" new result is a VALID INVENTION.

A & P Tea Co. v. Supermarket Corp., 340 U. S. 147, 151;

Photochart v. Photo Patrol, 189 F. 2d 625, 627 (9th C. A.);

Ingersoll Rand Co. v. Black & Decker Mfg. Co., 192 F. 2d 270, 273 (4th C. A.);

Interstate Rubber Products Corp. v. Radiator Specialty Co., 114 Fed. Supp. 120, 123.

B. The Facts.

The Hillgren NEW combination IN FACT produces a "SURPRISINGLY" new result.

This was conclusively PROVEN in the record herein, and FOUND by the District Court, as is shown by some parts of the record that are summarized below and excerpted in "APPENDIX D" accompanying this brief instead of at this point in order to keep this brief "concise."

The Hillgren NEW combination has not only ONE but SEVEN "SURPRISINGLY" NEW RESULTS that are fully described in "APPENDIX D" and may be briefly summarized as follows:

(1) WORLD'S FIRST DEADLATCHED REVERSE ROCKER TYPE LOCK.

(2) A NEW FUNCTION, DEADLOCKING, IS ADDED TO REVERSE ROCKER TYPE LOCKS.

(3) DEADLOCKING MECHANISM INCORPORATED IN THE MIDST OF A REVERSE ROCKER TYPE LOCK.

(4) NUMBER OF PARTS REDUCED TO LESS THAN ONE-THIRD. [R. pp. 628-634.]

(5) NUMBER OF MACHINING OPERATIONS REDUCED TO LESS THAN ONE-FOURTH. [R. pp. 570-574.]

(6) QUANTITY PRODUCTION OF 14,400 LATCHES PER DAY ACHIEVED BY THE HILLGREN INVENTION. [R. pp. 581-582.]

(7) IT IS IMPOSSIBLE TO COMBINE PRIOR ART REVERSE ROCKER TYPE LOCKS WITH PRIOR ART DIRECT ACTION TYPE DEADLATCHES SO HILLGREN'S NEW ELEMENT—HIS NEW DOG OR DEADLATCH SUB-COMBINATION—SOLVED A THERETOFORE INSOLVABLE PROBLEM BY THE INVENTION OF A NEW ELEMENT.

Therefore, on this third, separate, ground the Hillgren NEW combination is a VALID INVENTION.

"Appendix D" shows CLEARLY that the NEW Hillgren combination produces not only ONE but SEVEN "SURPRISINGLY" NEW RESULTS, EACH of which, under the authorities cited hereinabove, lifts this case out from under the rule in the *A & P Tea Co. v. Supermarket Corp.* case, *supra.*

Petitioner has thus clearly shown that there are THREE EXCEPTIONS to the *A & P Tea Co.* case, *supra,* ANY ONE of which will lift a patent out from under the *A & P Tea Co.* case, *supra,* namely:

1. A NEW ELEMENT.
2. A NEW MODE OF OPERATION, or
3. A "SURPRISINGLY" NEW RESULT.

Petitioner has also shown, indisputably, that the FACTS in this case show that the Hillgren combination in suit has NOT ONLY ONE but ALL THREE of these EXCEPTIONS in it.

Presence of any ONE of these THREE EXCEPTIONS proves "INVENTION."

Therefore the Petitioner respectfully submits that the prayed-for Writ of Certiorari should be granted herein so that the Supreme Court can exercise its SUPERVISION; can RIGHT the obvious wrong that has been done by the Court of Appeals in this case; and can SETTLE and PROMULGATE the law of these three "exceptions" to its decision in the *A & P Tea Co.* case for all cases to come after this case.

Summary.

The foregoing facts ESTABLISH and PROVE CONCLUSIVELY that the Hillgren NEW combination is a VALID INVENTION because it has:

a. A NEW ELEMENT.

b. A NEW MODE OF OPERATION.

c. A "SURPRISINGLY" NEW RESULT.

Under the cited DECISIONS of the LOWER COURTS and the DICTA of the Supreme Court ANY ONE of these three exceptions to the rule promulgated by the Supreme Court in the *A & P Tea Co.* case, *supra,* constitutes a VALID INVENTION.

No DECISION has yet been made by the Supreme Court on any of these exceptions to its rule in the *A & P Tea Co.* case.

ALL THREE of these exceptions are AT ISSUE in THIS case.

Therefore it is of GREAT PUBLIC MOMENT that this Court grant the prayed-for Writ of Certiorari herein and PROMULGATE ITS RULING on these THREE EXCEPTIONS to its rule in the *A & P Tea Co.* case, *supra,* IN ORDER TO HELP POSTERITY CORRECTLY RESOLVE MANY QUESTIONS OF "INVENTION."

Conclusion.

The Supreme Court should grant the prayed-for Writ of Certiorari in this case in order to complete its restatement of the law in *Great Atlantic and Pacific Tea Co. v. Supermarket Corp.*, 340 U. S. 147, by itself stating and defining by actual RULINGS, not just DICTA, for the FIRST TIME, the three exceptions that lift a patent outside of the *A & P Tea Co.* case, namely:

1. A NEW ELEMENT.
2. A NEW MODE OF OPERATION.
3. A "SURPRISINGLY" NEW RESULT.

Also, since the Hillgren patent in suit has at least ONE and probably ALL of these THREE exceptions in it, the Court of Appeals has so MISAPPLIED and MISINTERPRETED this Court's decision in the *A & P Tea Co.* case, and is in such conflict with other decisions of Courts of Appeal that the Supreme Court should grant this prayed-for Writ of Certiorari so that it can exercise its SUPERVISING AUTHORITY in this case involving a CONSTITUTIONAL LAW ISSUE, namely, the "INVENTION" PRESENT IN THE HILLGREN PATENT IN SUIT.

It is believed, therefore, that the questions of law involved are of great importance and should be determined by this Court.

Respectfully submitted,

HAMER H. JAMIESON,

Attorney for Petitioner.

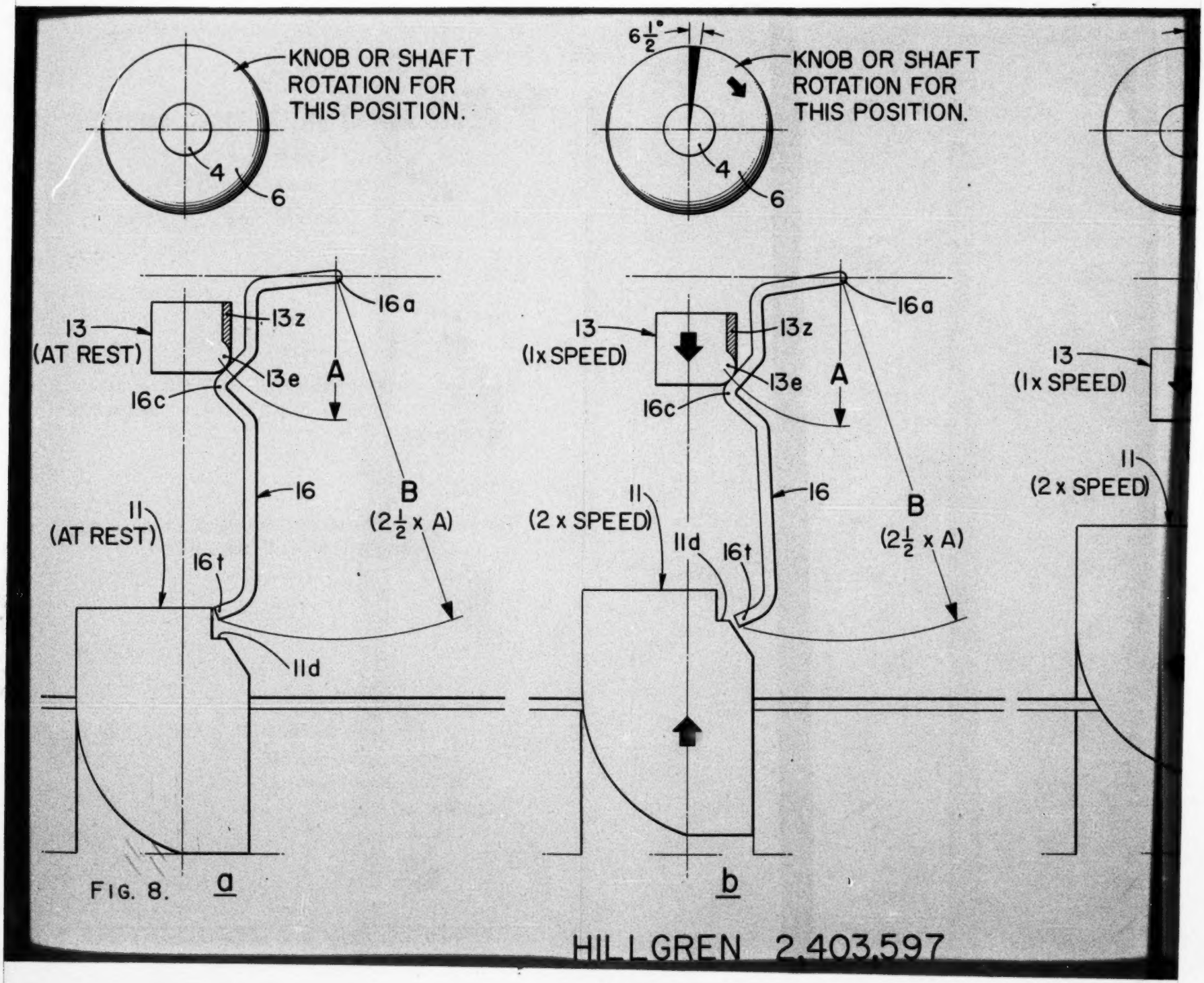
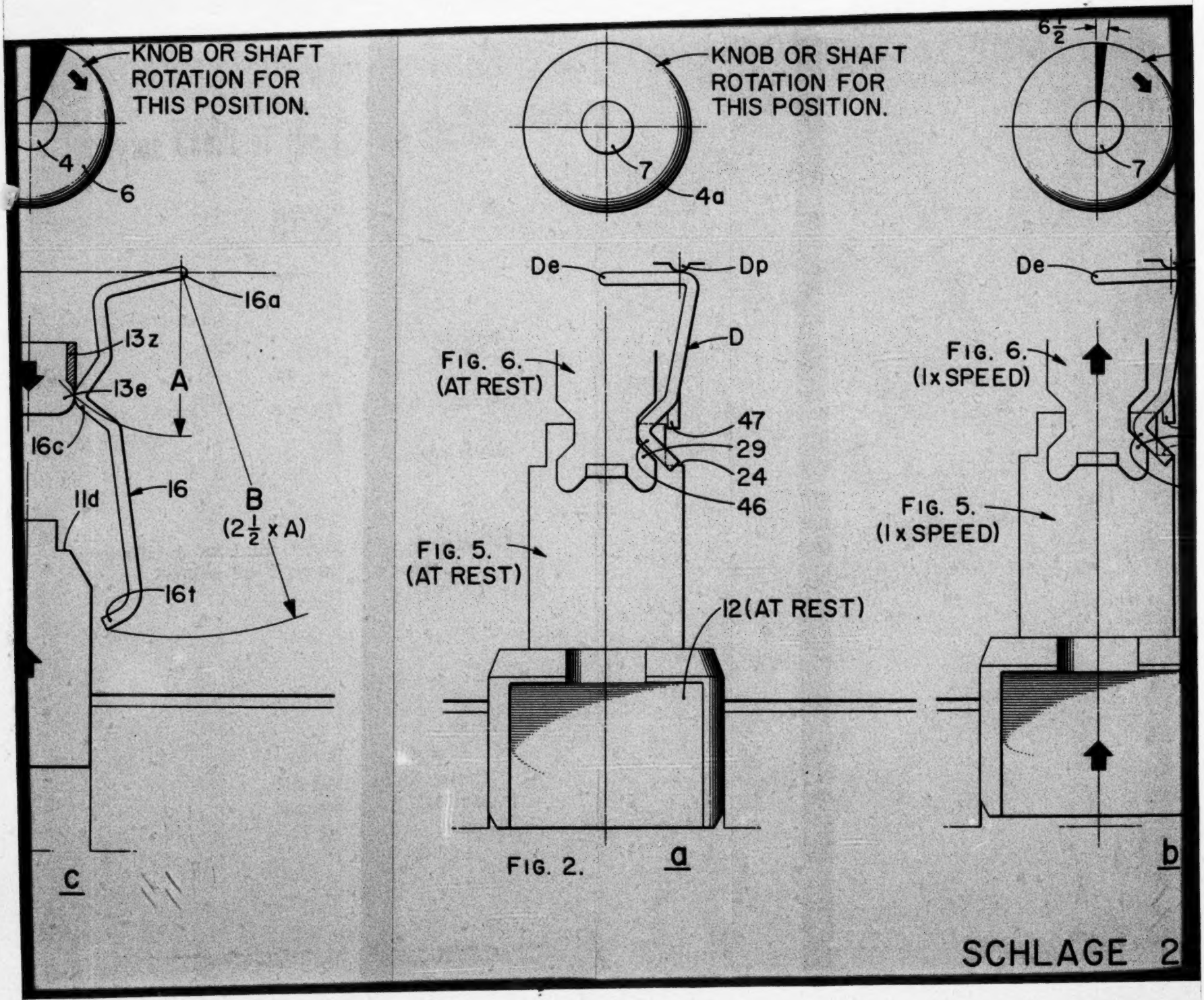
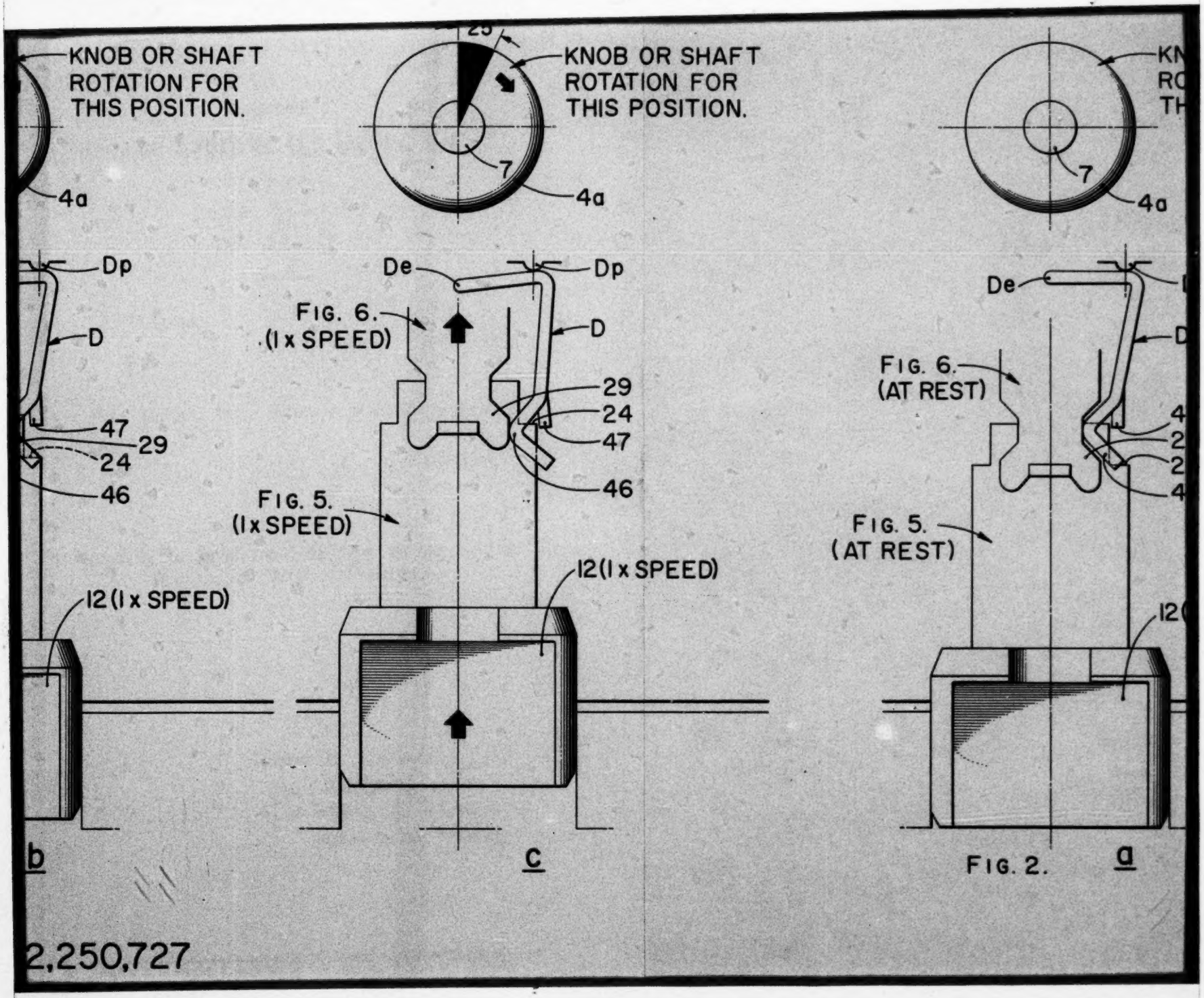


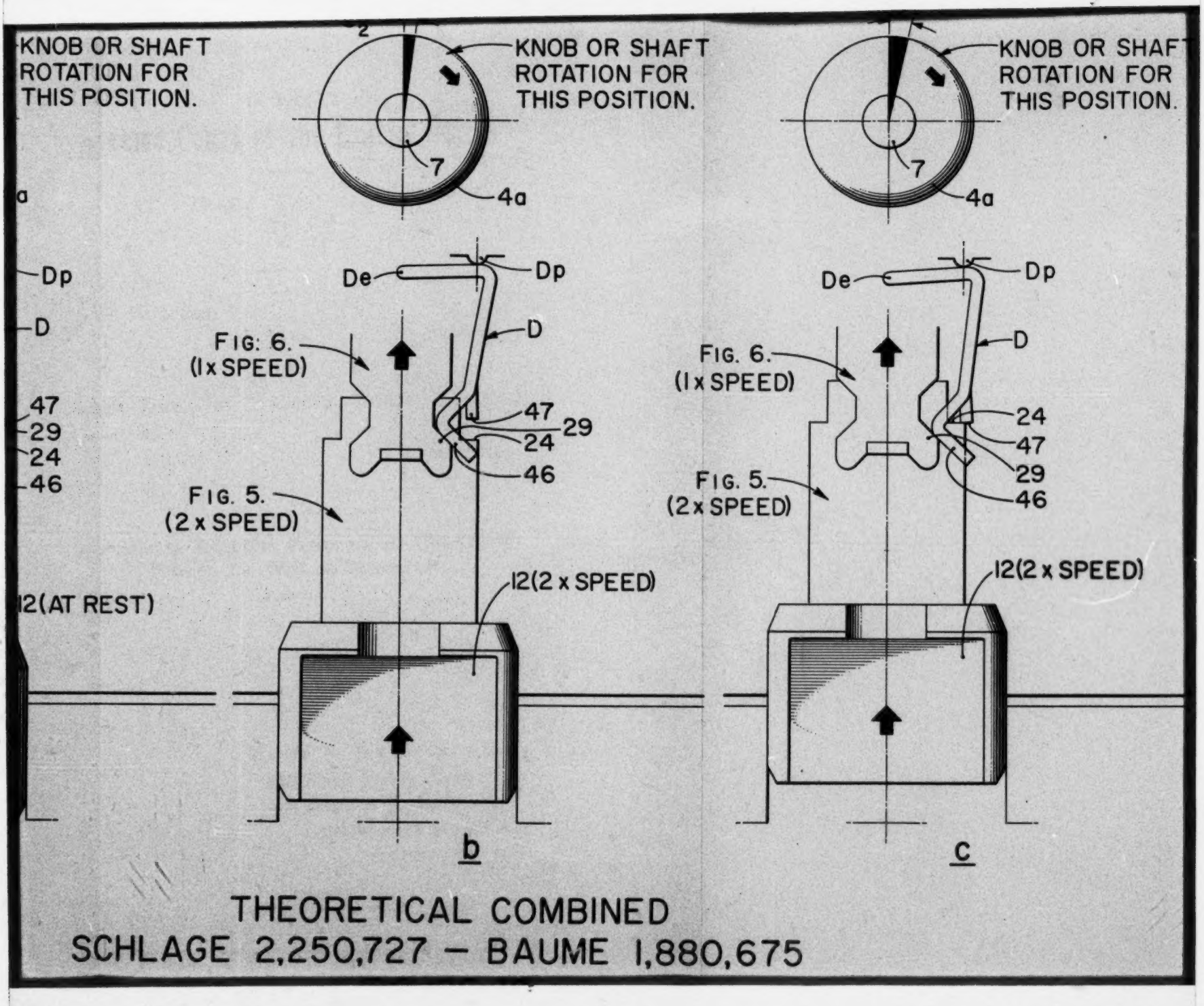
FIG. 8.

HILLGREN 2,403,597


KNOB OR SHAFT ROTATION FOR THIS POSITION.
4
6
KNOB OR SHAFT ROTATION FOR THIS POSITION.
7
4a
6½
7
16a
13z
13e
A
16c
16
11d
B
(2½ x A)
16t
C
De
Dp
D
FIG. 6. (AT REST)
47
29
24
46
FIG. 5. (AT REST)
12 (AT REST)
FIG. 2.
a
De
FIG. 6. (1x SPEED)
FIG. 5. (1x SPEED)
b
SCHLAGE 2


KNOB OR SHAFT ROTATION FOR THIS POSITION.
4a
Dp
D
47
29
24
46
12 (1 x SPEED)
b
25
KNOB OR SHAFT ROTATION FOR THIS POSITION.
7
4a
De
Dp
FIG. 6. (1 x SPEED)
D
29
24
47
46
FIG. 5. (1 x SPEED)
12 (1 x SPEED)
c
7
4a
De
FIG. 6. (AT REST)
FIG. 5. (AT REST)
FIG. 2.
a

2,250,727


KNOB OR SHAFT ROTATION FOR THIS POSITION.
KNOB OR SHAFT ROTATION FOR THIS POSITION.
KNOB OR SHAFT ROTATION FOR THIS POSITION.
7
4a
Dp
De
D
FIG. 6. (1x SPEED)
FIG. 5. (2x SPEED)
47
29
24
46
12(AT REST)
12(2x SPEED)
b
c
THEORETICAL COMBINED
SCHLAGE 2,250,727 – BAUME 1,880,675

INDEX TO APPENDIX.

PAGE

Appendix "A":

(a) A new element 1

A. The law 1

A & P Tea Co. v. Supermarket Corp., 340 U. S. 147 1

Photochart v. Photo Patrol, 189 F. 2d 625 2

E-I-M Co. v. Philadelphia Gear Works, 205 F. 2d 28 2

Jeoffroy Mfg. Co. v. Graham, 206 F. 2d 772 3

Guiberson Corp. v. Garrett Oil Tools, Inc., 205 F. 2d 660 3

Aeration Processes v. Lange, 196 F. 2d 981 5

Artmoore v. Dayless Mfg. Co., 109 F. Supp. 181 .. 5

Summary of law point 7

Appendix "B":

(b) A new mode of operation 8

A. The law 8

United Specialties Co. v. Industrial Corp., 186 F. 2d 428 8

Oliver United Silvers Corp. v. Silver, 206 F. 2d 658 8

Great A & P Tea Co. v. Supermarket Corp., 340 U. S. 147 9

Summary of law point 9

PAGE

Appendix "C":

(g) A "surprisingly" new result 10

A. The law 10

A & P Tea Co. v. Supermarket Corp., 340 U. S. 147 10

Photochart v. Photo Patrol, 189 F. 2d 625 10

Ingersoll Rand Co. v. Black & Decker Mfg. Co., 192 F. 2d 470 10

Interstate Rubber Products Corp. v. Radiator Specialty Co., 114 F. Supp. 120 11

Sumary of law point 12

Appendix "D" 13

APPENDIX "A."

(a) A NEW ELEMENT.

A. The Law.

A & P TEA CO. V. SUPERMARKET CORP., 340 U. S. 147:

(The Supreme Court itself indicates in the A & P Tea Co. case that the rule will be otherwise if ALL of the elements are NOT old.)

At page 148:

> "The District Court explicitly found that EACH element in this device was KNOWN to the prior art." (Emphasis ours.)

(This indicates that the rule will be otherwise if a SINGLE element is NEW.)

At page 148:

> "The Court of Appeals . . . identified NO other NEW or DIFFERENT element to CONSTITUTE INVENTION." (Emphasis ours.)

(This also infers that if there is a NEW OR DIFFERENT element it will constitute "invention".)

At page 149:

> "What indicia of invention should the Court seek in a case where NOTHING tangible is NEW and invention, if it exists at all is only in bringing old elements together?" (Emphasis ours.)

(This in effect says flatly that a NEW combination containing a NEW element and some old elements may be patentable "invention".)

At page 152:

"Elements may . . . take on some NEW QUALITY or FUNCTION from being brought into concert." (Emphasis ours.)

(This indicates that the NEWNESS of an element necessary to impart "invention" to the combination may be a NEW QUALITY or NEW FUNCTION taken on by an otherwise "old" element "from being brought into" the combination.)

PHOTOCHART V. PHOTO PATROL, 189 F. 2D 625 (9TH C. A.):

(The Ninth Court of Appeals, in negative phraseology, clearly indicates that a NEW or DIFFERENT ELEMENT in a combination will cause the combination to be a patentable invention.)

At page 627:

"It is NOT contended that the patent in suit contains any NEW or DIFFERENT ELEMENT not existing in the prior art." (Emphasis ours.)

E-I-M CO. V. PHILADELPHIA GEAR WORKS, 205 F. 2D 28 (5TH C. A.):

(The Fifth Court of Appeals distinguishes this case from the A & P Tea Co. case ON THE GROUND THAT NEW elements are present in the COMBINATION, and therefore that "invention" is present and the patent is valid.)

At page 30:

"Upon our consideration of the RECORD, and the TESTIMONY of the witnesses on behalf of both the appellant and the appellee, we find the evi-

dence is fully sufficient to support the FINDINGS of the TRIAL COURT to the ultimate effect, that Claim 2 of the Ball Patent, though it comprises some elements which are old, nevertheless, INCLUDES ELEMENTS WHICH ARE NOVEL, NOT DISCLOSED BY THE PRIOR ART, and the combination of which perform and produce a NEW and different useful function of OPERATION, THUS THE CASE IS TAKEN WITHOUT (*i.e.*, 'OUTSIDE OF') THE DECISION IN Great A & P Tea Co. v. Supermarket, Inc., 340 U. S. 147, relied upon by the Appellants." (Emphasis ours.)

JEOFFROY MFG. CO. V. GRAHAM, 206 F. 2D 772 (5th C. A.):

(The Fifth Court of Appeals again held, in this case, that a NEW ELEMENT in a combination that produces a new result makes that combination a valid "invention" and hence not invalid under the A & P Tea Co. case.)

At page 777:

"The Graham patent may not here be invalidated under the tests for invention laid down in the A & P Tea Co. case, *supra,* since that case involved only united OLD elements 'with no change in their respective functions' WHEREAS the patent here involved COMBINES BOTH old AND NEW ELEMENTS to produce a new result. See 340 U. S. 147, 151, 152." (Emphasis ours.)

GUIBERSON CORP. V. GARRETT OIL TOOLS, INC., 205 F. 2D 660 (5TH C. A.):

(The Court says that the law is clear, but the decision turns on the APPLICATION of the law to the facts—which is where the Court of Appeals fell into error in the instant case (Hillgren v. Kwikset) by failing to recognize

that the A & P Tea Co. case DOES NOT APPLY to Hillgren v. Kwikset BECAUSE HILLGREN HAS NEW ELEMENTS, A NEW MODE OF OPERATION AND "SURPRISINGLY" NEW RESULTS THAT ARE NOT FOUND IN THE PRIOR ART.)

At page 662:

> "It will serve no useful purpose to discuss the authorities each (party) cites. There is no real difference of opinion between the parties as to the controlling legal principles.
>
> "The dispute arises ON THEIR APPLICATION TO THE FACTS.
>
> "The DECISION OF THE CASE, in short, TURNS ON THE FACTS AS TESTIFIED TO AND FOUND." (Emphasis ours.)

(Thus in that case, as in Hillgren's, the law is clear and the facts are clear—THE COURT SIMPLY APPLIED THE WRONG LAW TO THE FACTS.)

(In short, the facts in Hillgren v. Kwikset are NOT like those in the A & P Tea Co. case. They are EXACTLY like the facts in E-I-M Co. v. Philadelphia Gear Works, 205 F. 2d 28, 30, and like the facts in Jeoffroy Mfg. Co. v. Graham, 206 F. 2d 772, 777, *supra.*)

(The Petitioner respectfully submits that the Supreme Court should grant the presently prayed for Writ of Certiorari so that it can promulgate, and correctly apply the rule in the latter two cases instead of the rule in the A & P Tea Co. case to the facts herein. This will result in the Supreme Court reversing the Ninth Court of Appeals and affirming the District Court which applied the CORRECT rule of law to the facts in this case.)

AERATION PROCESSES V. LANGE, 196 F. 2D 981 (8TH C. A.):

(The Eighth Court of Appeals reversed the District Court and found invention in a new combination of one NEW element (nitrous oxide) in the new combination and holding that this lifted the case outside of the rule of the A & P Tea Co. case.)

At page 983:

> "Our conclusion from consideration of all prior art and publications that has been cited to us is that there was no earlier teaching to inform anyone familiar with it that 'nice' and 'stiff' 'whipped cream' would be produced by USING NITROUS OXIDE (a NEW element) which cream in the way that Getz proposed and that his lighting upon the process WAS INVENTION.
>
> "He SATISFIED THE REQUIREMENTS of patentable invention even of the concurring minority in Great A & P Tea Co. v. Supermarket Corp., 340 U. S. 147 . . .
>
> "Nobody will EVER be tempted to go back again to a crude beating of air into rich cream to make whipped cream for commercial use." (Emphasis and parenthetical remarks ours.)

ARTMOORE V. DAYLESS MFG. CO., 109 F. SUPP. 181:

(Here still another Court held that a NEW ELEMENT in a combination rendered the patent valid and lifted it out from under the rule in the A & P Tea Co. case. THIS IS ALSO A VERY CLEAR SHOWING OF THE REASONING BEHIND THE POINT.)

At pages 183 to 184:

"The defendants' position that mere mechanical skill in the use of elements old in the art is not patentable invention represents a correct statement of law. (Citing cases.)

"The DIFFICULTY with this position is the FACT that it is NOT APPLICABLE to the case before the bar.

"A careful examination of the patent CLAIMS in suit discloses a combination of three basic elements which make up a device with advantages not possessed by the devices responding to the prior patents.

"Of these three elements, two are old . . .

"The rigid frame unit with its rollers at opposite sides thereof in fixed predetermined spaced relation is NOT DISCLOSED in the prior art; IT IS ENTIRELY NEW.

"As this Court views the evidence before it, it does NOT find in the plaintiff's device a conjunction or concert of KNOWN elements WHICH MUST CONTRIBUTE SOMETHING IN ORDER THAT THE DEVICE BE PATENTABLE. Great Atlantic & Pacific Tea Co. v. Supermarket Corp., 340 U. S. 147.

"ON THE CONTRARY, it finds that the patent in suit discloses a combination in a device, which introduces AN ENTIRELY NEW ELEMENT in the art, the rigid frame unit with its fixed spacing of the rollers.

"In the Court's view, this rigid frame unit is THE IMPORTANT ELEMENT in the combination which possesses several practical advantages. . . .

"The Court has carefully examined the sixteen patents which have been introduced by the defendants.

"It finds that NONE of them disclose the combination of the patent in suit.

"They all LACK what this Court considers the KEY element in the plaintiff's disclosure, the rigid frame unit with the fixed spacing of the rollers. . . .

"Defendants' exhibits advance sixteen patents, NONE of which offer a SATISFACTORY SOLUTION to the problem. . . . This would appear to be PERSUASIVE of the FUTILITY of the PRIOR ATTEMPTS to solve the problems. Ricwil Co. v. Kaiser Co., 7th Cir., 179 F. (2d) 401." (Emphasis ours.)

Summary of Law Point.

(Petitioner did not find a single case where a combination containing a NEW ELEMENT was held invalid for lack of invention under the A & P Tea Co. case, *supra*.

(Therefore the above authorities establish the law to be that:

(A NEW combination containing a NEW ELEMENT and producing a new and beneficial result is a VALID INVENTION.)

APPENDIX "B."

(b) A NEW MODE OF OPERATION.

A. The Law.

UNITED SPECIALTIES CO. V. INDUSTRIAL CORP., 186 F. 2D 428 (6TH C. A.):

(The Sixth Court of Appeals indicates that a NEW MODE OF OPERATION will establish "invention" in a new combination of old elements that produces a new and beneficial result, though it found none in the particular case at bar.)

At page 429:

> "While the Court (below) thought that Zander had produced a new combination with a NEW MODE OF OPERATION and new and beneficial results, we find difficulty in sensing either." (Emphasis ours.)

OLIVER UNITED SILVERS CORP. V. SILVER, 206 F. 2D 658 (10TH C. A.):

(The Tenth Court of Appeals held that a NEW MODE OF OPERATION made a new combination valid, and hence showed "invention".).

At page 663:

> "We think that the trial Court's finding that Silver's patent disclosed 'new combinations in the process and apparatus' which 'EMPLOY A NEW MODE OF OPERATION and produce a new and improved result over anything existing in the prior art' is sustained by the evidence." (Emphasis ours.)

GREAT A & P TEA CO. V. SUPERMARKET CORP., 340 U. S. 147:

(The Supreme Court itself states the rule in negative, or corollary, form as dicta in the A & P Tea Co. case.)

At page 151:

> "The negative rule accrued from many limitations was condensed about as precisely as the subject permits in Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U. S. 545, 549:
>
> " 'The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce NO NEW or DIFFERENT FUNCTION or OPERATION than theretofore PERFORMED or produced by them is not patentable invention.' (Citing Toledo v. Standard, 307 U. S. 350 and Cuno v. Automatic, 314 U. S. 84.)" (Emphasis ours.)

Summary of Law Point.

(Petitioner found no case where a combination containing a NEW MODE OF OPERATION was held invalid for lack of "invention" under the A & P Tea Co. case, *supra*.

(Therefore the above authorities show that the law is settled that:

> (A NEW combination containing a NEW MODE OF OPERATION and producing a new and beneficial result is a VALID INVENTION.)

APPENDIX "C."

(g) A "SURPRISINGLY" NEW RESULT.

A. The Law.

A & P TEA CO. V. SUPERMARKET CORP., 340 U. S. 147:

(The Supreme Court states the rule negatively in the A & P Tea Co. case as follows):

At page 151:

> "This case is wanting in any UNUSUAL or 'SURPRISING' CONSEQUENCES from the unification of the elements here concerned." (Emphasis ours.)

PHOTOCHART V. PHOTO PATROL, 189 F. 2D 625 (9TH C. A.):

(The Ninth Court of Appeals cited the A & P Tea Co. case, *supra,* and then said the test is "unusual or SURPRISING" results.)

At page 627:

> "The test to be applied to such patents is that the combination must perform some new or different function—one that has UNUSUAL or SURPRISING CONSEQUENCES." (Emphasis ours.)

INGERSOLL RAND CO. V. BLACK & DECKER MFG. CO., 192 F. 2D 470 (4th C. A.):

(The Fourth Court of Appeals gave a clear example of what constitutes an "UNUSUAL", or "SURPRISING" result.)

At page 473:

> "Pott did NOT design the FIRST portable, automatic nut runner." (Emphasis ours.)

(NOTE: In contradistinction the Ninth (a) FINDING OF FACT in Hillgren v. Kwikset [R. p. 24], was that Hillgren, in the patent in suit, DID invent)

> "The world's FIRST deadlatched reverse rocker type lock." [R. p. 24.] (Emphasis ours.)

(Surely, the Hillgren combination completely meets THIS test of a "SURPRISING" NEW RESULT.)

INTERSTATE RUBBER PRODUCTS CORP. V. RADIATOR SPECIALTY CO., 114 F. Supp. 120:

(This District Court spells out the meaning of "surprising" results in language that is fresh and clear.)

At page 123:

> "One among the essential requirements for the validity of a patent is that the subject matter display 'invention'—'more ingenuity . . . than the work of a mechanic skilled in the art.' Hicks v. Kelsey, 18 Wall. 670, and many other cases cited therein.
>
> "This test is often difficult to apply BUT ITS PURPOSE IS CLEAR.
>
> "Under this test some SUBSTANTIAL INNOVATION is necessary . . . an innovation to which SOCIETY IS DIRECTLY INDEBTED to the efforts of the patentee.
>
> "Whether or not those efforts are of a special kind does not concern us.
>
> "THE PRIMARY PURPOSE OF OUR PATENT SYSTEM IS not reward of the individual, but ADVANCEMENT OF ARTS AND SCIENCES. Sinclair & Carol Co. v. Inter-chemical Corp., 325 U. S. 327." (Emphasis ours.)

Summary of Law Point.

(Thus the law is clear that, even if all of the elements are old and even if there is no new mode of operation, a combination can STILL AMOUNT TO INVENTION if the new and beneficial result obtained or produced is sufficiently "UNUSUAL" or "SURPRISING", or if it sufficiently "ADVANCES THE ARTS OR SCIENCES."

(Therefore, the above authorities show that the law is well settled that:

(A NEW combination that produces a "SURPRISINGLY" new result is a VALID INVENTION.)

APPENDIX "D."

(1) World's FIRST DEADLATCHED REVERSE ROCKER TYPE LOCK.

Finding 9a of the District Court [R. p. 24] found this as a FINDING OF FACT, and the record amply supports it.

Before Hillgren there were NO DEADLATCHED REVERSE ROCKER TYPE LOCKS OF ANY KIND, though the first reverse rocker type lock, Baume, had issued twelve (12) years before Hillgren.

The fact that many direct action type lock owners had obtained patents on deadlatch mechanisms for their locks shows:

a. The need and demand and

b. The "INVENTION" present in Hillgren.

In Ingersoll Rand Co. v. Black & Decker Mfg. Co., 192 F. 2d 470, the Fourth Court of Appeals said at page 473 that Potts did not invent the FIRST device of his class, thereby inferring that if he had it would have been "invention".

Hillgren DID invent the FIRST device of HIS class. His patent in suit is the World's FIRST deadlatched reverse rocker type lock. [R. p. 24.] Hence it is not only an invention, BUT A PIONEER invention.

As has been too often the case the lower (Appeal) Court has mistaken a "pioneer" patent for lack of invention because, after it has been invented it seems too easy or too simple to them.

But if the art before Hillgren is surveyed the problem that Hillgren solved by the patent in suit seems INSUR-

MOUNTABLE when only the available prior art is considered.

That is one reason why the fact that Hillgren solved that problem is "SURPRISING" and "PIONEER"!

(2) A NEW FUNCTION, DEADLOCKING, IS ADDED TO REVERSE ROCKER TYPE LOCKS.

Finding 9c of the District Court [R. p. 24] specifically finds this NEW FUNCTION or RESULT to be in the Hillgren combination in suit.

This is, clearly, a "SUBSTANTIAL INNOVATION" to which "SOCIETY IS DIRECTLY INDEBTED TO THE EFFORTS OF THE PATENTEE." (Sinclair & Carol Co. v. Inter Chemical Corp., 325 U. S. 327, cited in Interstate Rubber Products Corp. v. Radiator Specialty Co., 114 F. Supp. at p. 123.)

It certainly meets the ACID TEST laid down by the Supreme Court in Great A & P Tea Co. v. Supermarket Corp., 340 U. S. 147 at page 151, namely the HILLGREN invention or NEW combination "performs or produces" a "NEW or DIFFERENT FUNCTION or OPERATION than theretofore PERFORMED or produced," namely, DEADLOCKING A REVERSE ROCKER TYPE LOCK!

THIS IS at LEAST, therefore, A "SURPRISINGLY" NEW RESULT.

(3) DEADLOCKING MECHANISM INCORPORATED IN THE MIDST OF A REVERSE ROCKER TYPE LOCK.

This is specifically found in Finding No. 9e [R. p. 24] by the District Court.

One of the time-honored tests used in deciding whether a device is an "invention" or a "mere aggregation" is to determine whether or not there is CO-OPERATION between all of the members or elements. If there is, it shows "invention." If there is not—like the rubber eraser on the end of the pencil—it is an "aggregation."

Mere examination of the Hillgren deadlocking mechanism incorporated IN THE MIDST of the POWER TRAIN of a reverse rocker type lock SHOWS the CLEAR CO-OPERATION between ALL of the elements of the claims in issue.

This is MOST PERSUASIVE EVIDENCE of the PRESENCE OF "INVENTION" IN HILLGREN.

Also it is a "STARTLINGLY" NEW RESULT that is NOT FOUND IN THE PRIOR ART!

(4) NUMBER OF PARTS REDUCED to less than ONE-THIRD. [R. pp. 628-634.]

The record shows that if Baume and Schlage could be combined (even though NO ONE has been able to figure out HOW it could be done) the combined lock would have 26 parts as against 8 for Hillgren. [R. pp. 629-630.]

This shows that Hillgren reduced the number of parts to LESS THAN ONE-THIRD. The infringing device made one part in three pieces and respondents argued that they had more parts (TWO more by this attempted evasion). But the Court found that this made no difference as the three parts did the same work in the same way as Hillgren's one part [Findings Nos. 10 and 11, R. p. 25]—and this attempt to CONFUSE the issue failed.

Certainly cutting the number of parts to LESS THAN ONE-THIRD and at the same time doing MORE work,

as well as the SAME work is a "STARTLINGLY" NEW RESULT, in and of itself.

(5) NUMBER OF MACHINING OPERATIONS REDUCED TO LESS THAN ONE-FOURTH. [R. pp. 570-574.]

This was found by the District Court in its Finding No. 9d. [R. p. 24.]

The record shows that if Schlage and Baume were combined it would require 29 operations [R. p. 570], whereas the Hillgren lock in actual manufacture requires only 6 or 7 operations. [R. p. 574.] The difference in cost IS OBVIOUSLY "CONSIDERABLE—at LEAST TWICE the cost." [R. p. 574.]

Six (6) is much less than one-fourth of 29 and seven (7) is also less than one-fourth of 29 machining operations, so either way IT IS STILL "LESS THAN ONE-FOURTH."

This is still another "SURPRISINGLY" NEW RESULT in Hillgren over the prior art.

(6) QUANTITY PRODUCTION OF 14,400 LATCHES PER DAY ACHIEVED BY THE HILLGREN INVENTION. [R. pp. 581-582.]

The uncontroverted record shows that the Hillgren invention made possible the production of 1,800 latches per hour and that Hillgren ran the conveyer set-up that makes them eight hours per day, making a total of 14,400 latches per day. [R. p. 581.]

On the other hand, the record shows that a combined Baume-Schlage lock, if it could be made at all, could only be made at the rate of not over ONE PER DAY. [R. p. 582.]

Certainly the difference between a production of one a day for the prior art, IF it could be made at all, and 14,400 PER DAY for the Hillgren invention is, at least, a "SURPRISINGLY" NEW RESULT! IT ALSO SHOWS GREAT COMMERCIAL SUCCESS, which is also EVIDENCE OF "INVENTION."

It is a result that would not be IMAGINED by reading the Hillgren patent. THEREFORE, when one hears for the first time that the invention actually accomplishes this AMAZING result in practice, it must be "SURPRISING" INDEED.

(7) IT IS IMPOSSIBLE TO COMBINE PRIOR ART "REVERSE ROCKER" TYPE LOCKS WITH PRIOR ART "DIRECT ACTION" TYPE DEADLATCHES SO HILLGREN'S NEW ELEMENTS—HIS DOG—HIS DEADLATCH SUB-COMBINATION—OR HIS NEW OPERATING MEMBER—SOLVED A THERETOFORE INSOLVABLE PROBLEM—BY HIS INVENTION OF HIS NEW ELEMENTS.

Even today—even with the light of Hillgren's invention—NO ONE has EVER been able to figure out ANY way to deadlatch a reverse rocker type lock by ANY means in the prior art, or EVEN by any means OTHER than that invented by Hillgren and covered by the patent in suit.

Respondents made and sold a reverse rocker type lock for many years and couldn't figure out how to deadlatch it.

Finally they had to buy one of Hillgren's locks and take it apart and copy it, as the record CLEARLY and

INDISPUTABLY shows. [R. pp. 559-564, incl., and pp. 588-589.]

This was BRAZEN PIRACY.

The action of the Court of Appeals in aiding and abetting this PIRACY by a MISINTERPRETATION of the decision of this (Supreme) Court in the A & P Tea Co. case, *supra*, is such a GROSS ERROR as to cry out for this (Supreme) Court to exercise its supervisory power through granting the prayed-for writ of certiorari herein, in order to correct this OBVIOUS MISTAKE and CLEAR ERROR that has been made by the Court of Appeals.

TOPICAL INDEX

Page

Certiorari will not ordinarily be granted in a patent infringement case merely for the purpose of reviewing question of invention and/or infringement 3

There is no conflict of decision 5

The Court of Appeals for the Ninth Circuit has correctly decided the case with a proper application of the law to the facts 10

TABLE OF CASES AND AUTHORITIES CITED

Cases

General Talking Pictures v. Western Electric Co. Inc., 304 U. S. 175 3

Keller v. Adams Campbell Co., 244 U. S. 314 3

Layne & Bowler Corp. v. Western Well Works, Inc., 261 U. S. 387 3

Locm Company v. Higgins, 105 U. S. 580 ..... 5, 6, 8, 10

Sargent v. Hall Safe & Lock Co., 114 U. S. 63 10

The Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation, 340 U. S. 147 ..... 5, 6, 10

Victor Cooler Door Company et al v. Jamison Cold Storage Door Company, 44 F. (2d) 288 11

IN THE

SUPREME COURT

OF THE

United States

October Term, 1953

CARL A. HILLGREN, *Petitioner,* vs. KWIKSET LOCKS, INC., ADOLPH SCHOEPE and KARL REINHARD. *Respondents.*	No. 698

BRIEF FOR RESPONDENTS KWIKSET LOCKS, INC., ET AL IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

To The Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Hillgren's Petition for Writ of Certiorari in this case should be denied for the following reasons:

1. This is but an ordinary patent infringement case with the usual issues of invention and infringement.

2. There are no conflicting decisions with respect to these issues by courts of appeal in different circuits requiring reconciliation or resolution by this court.

3. That part of the case from which Hillgren has petitioned has been correctly decided by the Court of Appeals for the Ninth Circuit with the proper application of the law to the facts. The court has held, and properly so, that the claims in issue of the Hillgren patent in suit are invalid. It has further held that respondent Kwikset has neither

"copied (n)or relied on Hillgren . . ."

and

"Thus, Kwikset does not infringe . . . ."

See Footnote 13 to the Opinion of the Court of Appeals at the bottom of page 906 of the record.

CERTIORARI WILL NOT ORDINARILY BE GRANTED IN A PATENT INFRINGEMENT CASE MERELY FOR THE PURPOSE OF REVIEWING QUESTION OF INVENTION AND/OR INFRINGEMENT.

In *Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U. S. 387, this Court said:

> ". . . It is very important that we be consistent in not granting the Writ of Certiorari except in cases involving principles, the settlement of which is of importance to the public as distinguished from that of the parties, and in cases where there is a real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal."

In *Keller v. Adams Campbell Co.*, 244 U. S. 314, this Court said:

> "Such an ordinary patent case with the usual issues of invention, breadth of claims and non-infringement, this court will not bring here by certiorari, unless it be necessary to reconcile decisions of the Circuit Court of Appeals on the same patent."

Again in *General Talking Pictures v. Western Electric Co., Inc.*, 304 U. S. 175, it is said:

> "Granting of the writ would not be warranted merely to review the evidence or inferences drawn from it." . . .
>
> "Nor would the writ be granted to review the questions of anticipation and invention that peti-

tioner argues, for as to them there is no conflict between decisions of the Circuit Courts of Appeals."

Petitioner Hillgren here is petitioning this Court to review the question of invention and while Petitioner urges that "Invention Is the Sole Issue", see Point I of Petitioner's Argument, it is obvious from the above quotation from Footnote 13 to the opinion of the Court of Appeals that the question of infringement is also an issue that has been decided adversely to Petitioner.

This case, as presented by the Hillgren petition, is merely another ordinary patent case in which the patentee is dissatisfied with the ruling of a Court of Appeals to the effect that his patent is neither valid nor infringed.

THERE IS NO CONFLICT OF DECISION

There is here no "real and embarrassing conflict of opinion and authority between the Circuit Courts of Appeal." On the contrary there is no conflict at all.

In *Loom Company v. Higgins*, 105 U. S. 580, this Court said:

> "It may be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result never attained before, it is evidence of invention."

On the other hand, in a more recent decision, *The Great Atlantic & Pacific Tea Company v. Supermarket Equipment Corporation*, 340 U. S. 147, this Court said:

> "Neither court below has made any finding that old elements which made up this device perform any additional or different function in the combination than they perform out of it. This counter does what a store counter always has done —it supports merchandise at a convenient height while the customer makes his purchases and the merchant his sales. The three-sided rack will draw or push goods put within it from one place to another—Just what any such a rack would do on any smooth surface—and the guide rails keep it from falling or sliding off the counter, as guide rails have ever done. Two and two have been added together, and still they make only four.
>
> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty

and improbability of finding invention in an assembly of old elements. The function of a patent is to add to the sum of useful knowledge. Patents cannot be sustained when, on the contrary, their effect is to subtract from former resources freely available to skilled artisans. A patent for a combination which only unites old elements with no change in their respective functions, such as is presented here, obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillfull men. This patentee has added nothing to the total stock of knowledge, but has merely brought together segments of prior art and claims them in congregation as a monopoly."

The real question here is whether or not the rule of *Loom Company v. Higgins, supra,* is applicable to the facts or whether the rule of *The A & P Tea Company* case is applicable. In other words, did Hillgren combine and arrange known elements in a new manner, thus producing a new and beneficial result, or did he merely bring old elements together where the result was nothing more than their anticipated or expected sum? It is respectfully submitted that the latter is the situation and that the rule of *The A & P Tea Company* case applies.

The facts of this case are briefly as follows:

1) A reverse rocker type door lock *per se* is old in the art. Such a lock is shown in such prior art patents as the Baume Patent No. 1,880,675, Ex. Bk. 876, and James Hillgren Patent No. 2,348,737, Ex. Bk. 885.

2) Deadlatching mechanisms for door locks *per se* were old in the art, such as are shown in the Schlage Patent No. 1,876,081, Ex. Bk. 875 and Schlage Patent No. 2,250,727, Ex. Bk. 880. Other illustrations of deadlatching mechanisms for door locks are found in the prior art. See

Brooks	921,513	Ex. Bk. 852
Fergusson	704,180	Ex. Bk. 858
Sparks	1,148,549	Ex. Bk. 869
Falk	2,293,645	Ex. Bk. 883
Voight	2,272,101	Ex. Bk. 881.

3) In combining the old deadlatching mechanism of the prior art with the old reverse rocker type door lock, all that Hillgren produced was a deadlatched reverse rocker type door lock. In other words "Two and two have been added together, and still they make only four."

Petitioner Hillgren in his petition lays great stress on the contention that by making the combination of a reverse rocker type door lock with a deadlatching mechanism that he gains a " 'Surprisingly' New Result", see petitioner's Argument attached to the petition, pages 1, 19, 20, 21, 22, and 23. Actually, there is nothing surprising about the combination whatsoever. By adding the old deadlatching mechanism to a reverse rocker type door lock all that is secured is "deadlocking, is added to the reverse rocker type locks." Petition page xx.

That the rule of *Loom Company v. Higgins* does not apply to the facts of this case is demonstrated by the testimony of Hillgren's expert witness, Beehler, who testified at R. 166-167 as follows:

"The Court: If I remember the answer correctly, I think the testimony discloses that there is nothing particularly new except the association of parts that were old in the art. As I said before, they have been making locks for a good many years, and this particular lock is not new. Now, it is a question of taking something that was in the public domain, prior art, putting it together so that it brings about a new and beneficial result, and that is all. That is my understanding. My understanding is that he testified yesterday that practically everything in the claims was found in prior art, and what they are claiming here is the fact that they put these different claims (things) together in a new and beneficial way. Now, isn't that correct?

"The Witness: *That is putting it simply, yes.*

"Q. (By Mr. Miller): *Just what was that new and beneficial way?* The putting together of the slide and the rocker and the main bolt and the spindle, was that this new and beneficial way Mr. Hillgren put these parts together?

"A. I don't know that I can fairly answer a question as broad as that.

"Q. *Could you state in layman's language just what new and beneficial way he put these parts together?*

"Mr. Jamieson: That is the same identical question that I have objected to. He has asked it three times, and your Honor has answered it for him.

"The Court: *He says he can't tell you.*

"Mr. Miller: If that is his testimony, I will drop it.

"Mr. Jamieson: He has already answered it.

"The Witness: I said I couldn't answer a question framed as broadly as that. (Italics added.)"

It is therefore submitted that there are no conflicting decisions with respect to the issue of invention raised by Petitioner Hillgren. The question is merely whether or not Hillgren combined old elements of the prior art in a new combination producing "a new and beneficial result never attained before", or whether he merely added together the old reverse rocker type door lock and the old deadlatching mechanism and thus produced "the world's first deadlatched reserve rocker type lock" wherein "deadlocking, is added to reverse rocker type locks."

THE COURT OF APPEALS FOR THE NINTH CIRCUIT HAS CORRECTLY DECIDED THE CASE WITH A PROPER APPLICATION OF THE LAW TO THE FACTS.

In determining whether or not the rule of *Loom Company v. Higgins* applies to the facts of this case, or the rule of *The A & P Tea Company* case applies, the Court of Appeals for the Ninth Circuit has decided the case correctly. Nothing could be clearer than that all that Hillgren did was to add two and two together and still obtain only four. The result is not surprising. "Dead locking is added to reverse rocker type locks" and that is all.

In making its decision the Court of Appeals has followed another decision of this Court, to-wit, *Sargent v. Hall Safe & Lock Co.*, 114 U. S. 63. That case concerned a patent for a combination lock for safes with a time device for controlling the release of the lock. Such time controls had been previously developed but had been previously used in connection with key locks. This Court quoted with approval the opinion of the Board of Examiners in the Patent Office as follows:

> " 'Nor, so far as we can see, has any invention been exercised. The time-movement was originally invented to prevent locks from being prematurely unlocked, and, when once the combination had been invented, it is obvious that it was applicable to one form of locks as to another; and, to grant

a patent for the union of the time-movement with every old form of lock or with every new form which might appear, would manifestly place unjust restrictions on the original invention and defeat the very purpose of the law.' "

The Court of Appeals herein in its opinion has paraphrased this statement and demonstrated its applicability to the facts of the present case. Here, deadlatching mechanisms like the time devices were originally invented to be applied to locks. When once the combination had been invented it is obvious that the deadlatching mechanism was as applicable to a reverse rocker type lock as it was to other types of locks. To grant a patent for a union of the deadlatching mechanism with every old form of lock, including the old reverse rocker type door lock, would manifestly place an unjust restriction upon the use by the public of the deadlatching mechanism of the prior art which has passed into the public domain.

The same principle was applied by the Court of Appeals for the Fifth Circuit in *Victor Cooler Door Company et al v. Jamison Cold Storage Door Company*, 44 F. (2d) 288. In that case which likewise dealt with door latches, the Court said:

"We do not think that it constituted patentable invention to equip the Jones latch with the Dodge push bar. The resulting latch is not a combination producing a new and useful result, but a mere aggregation in which old devices are brought together and each allowed to work out its own effect.

The outside mechanism works exactly as it did in the Jones patent. The push bar releases the latch by pushing out the lever, exactly as it did in the Dodge and Millard patents. It is clear that this does not constitute invention. *Walker on Patents*, 6th Ed. vol. 1, 84 and 92; *Grinnell Washing Machine Co. v. E. E. Johnson Co.*, 247 U. S. 426; *Palmer v. Corning*, 156 U. S. 342; *Hall v. McNeale*, 107 U. S. 90; *Heald v. Rice*, 104 U. S. 737, 754; *Hailes v. Van Wormer*, 20 Wall. 353; *Stimpson v. Woodman*, 10 Wall. 117."

In the present case the old deadlatching mechanism and the old reverse rocker type door lock have merely been brought together and "each allowed to work out its own effect."

It is, therefore, submitted that the Court of Appeals for the Ninth Circuit herein is acting consistently with decisions of this Court and decisions of other Circuit Courts of Appeal. It has properly applied the law to the facts of this case and has arrived at a just and logical decision.

Hillgren's Petition for a Writ of Certiorari consequently should be denied on this ground alone.

On the question of infringement considerable stress is placed in the Petition on the fact that in the Hillgren patent the operating member 13 effects a shifting of the dog from deadlatching position to releasing position when the spindle is turned. Claims 1 and 2 of the Hillgren patent, which are the only claims that are in issue, specifically recite that

"the operating member (is) engaging the dogging member whereby the free end of the latter is shifted from the path of movement of the main latch member to allow retraction of the latter."

This very contention demonstrates that the Court of Appeals was correct in its holding of non-infringement because the accused construction does not employ the operating member to shift the dog. On the contrary, a separate drive is provided between the dog and the spindle so that the spindle shifts the dog from deadlatching to releasing position before the operating member is even moved. This separate drive is provided by an actuator and a spring associated therewith so that the accused Kwikset lock has not only a different design, a different mode of operation, but requires more parts and more machining operations in its production than the patented lock. There, consequently, was no infringement.

It is respectfully submitted that Hillgren's Petition for a Writ of Certiorari should be denied.

Respectfully submitted,

Fred H. Miller, Esq.
Attorney for Kwikset Locks, Inc.

CERTIORARI DENIED